UNITED STATES CIRCUIT COURT OF APPEALS,

FOR THE SEVENTH CIRCUIT.

OCTOBER TERM, A. D. 1891.

No. 26.

THE MOLINE PLOW COMPANY,

Appellant,

vs.

THE EAGLE MANUFACTURING COMPANY,

Appellee.

Appeal from the Circuit Court of the United States for the Northern District of Illinois, Northern Division.

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IN THE CIRCUIT COURT OF THE UNITED STATES, FOR THE NORTHERN DISTRICT OF ILLINOIS, NORTHERN DIVISION.

SATURDAY, November 7, 1891.

Present: Honorable HENRY W. BLODGETT,
District Judge.

The Eagle Manufacturing Company,
v.
The Moline Plow Company.
} *In Chancery.*

On motion it is ordered that the time for completing the record on appeal herein be extended thirty days.

NORTHERN DISTRICT OF ILLINOIS,
NORTHERN DIVISION.
} ss.

I, William H. Bradley, clerk of the Circuit court of the United States, for said Northern district of Illinois, do hereby certify the above and foregoing to be a true and correct copy of the order entered of record in said court at Chicago in said division, on the 7th day of November, A. D. 1891, in the cause wherein The Eagle Manufacturing Company is the complainant and the Moline Plow Company is the defendant, as the same appears from the original records of said court now remaining in my custody and control.

In Testimony whereof, I have hereunto set my hand and affixed the seal of said court, at my office in Chicago, in said district, this 13th day of November, A. D. 1891.

[SEAL.] WM. H. BRADLEY,
Clerk.

[Endorsed]: Nov. 13, 1891.

OLIVER T. MORTON, *Clerk.*

IN THE

CIRCUIT COURT OF THE UNITED STATES,

FOR THE NORTHERN DISTRICT OF ILLINOIS,

NORTHERN DIVISION.

THE EAGLE MANUFACTURING COMPANY,
vs.
THE MOLINE PLOW COMPANY.
} *In Chancery.*

Pleas in the Circuit court of the United States for the Northern district of Illinois, Northern Division, held at the United States court rooms in the city of Chicago, in the district aforesaid, before the Honorable Henry W. Blodgett, Judge of the District court of the United States for the Northern district of Illinois, on Wednesday the seventh day of October, in the adjourned October term of said court, in the year of our Lord one thousand eight hundred and ninety-one, and of our Independence the one hundred and sixteenth year.

WM. H. BRADLEY,
Clerk.

The Eagle Manufacturing Company,
v.
The Moline Plow Company.
} *In Chancery.*

NORTHERN DISTRICT OF ILLINOIS, ss.

Be it remembered that on the thirteenth day of July, 1891, there was filed in the office of the clerk of the Circuit court of the United States for the Northern district of Illinois, at Chicago, in said district, the opinion of Judge Blodgett in said entitled cause, which said opinion is in the words and figures following, to-wit:

OPINION.

The Eagle Manufacturing Company,
v.
The Moline Plow Company.

BLODGETT, J.

Opinion, filed July 13, 1891.

The bill in this case charges the defendant with the infringement of the same patent involved in the preceding case against the David Bradley Manufacturing Company, and the defense interposed is the same as in that case. The bill in this case also charges that in December, 1887, complainant brought suit in the Southern district of Iowa, by bill in chancery, against the Moline, Milburn & Stoddard Company for an alleged infringement of the same letters patent. That the defendant in that case was a branch house of the Moline Plow Company, the defendant in this case, and was engaged in selling the identical cultivators, manufactured by the defendant herein, and which in this case complainant charges, infringed complainant's patent; that such proceedings were had in that case as that a decree was entered, finding the defendant in that case guilty of the infringement charged, and an injunction against such further infringement duly entered.

That the defendant in this case took the control and charge of the defense in that case, and by its own attorneys, and at its own expense, conducted such defense, and that, therefore, this defendant is estopped by the decree in that case.

The proofs fully sustained this allegation in the bill, and bring the case wholly within the rule laid down in the prior case of this complainant against the David Bradley Manufacturing Company.

A decree will, therefore, be entered, finding that the defendant infringed, and for an injunction and accounting.

[Endorsed]: Filed July 13, 1891.

WM. H. BRADLEY, *Clerk.*

Afterward, to-wit: On the seventh day of October, in the adjourned October term of said court, 1891, in the record of the proceedings thereof in said entitled cause before Honorable Henry W. Blodgett, District Judge, is the following entry, to-wit:

DECREE.

The Eagle Manufacturing Company,
v.
The Moline Plow Company. } *In Chancery.*

Decree, entered October 7, 1891.

And now, to-wit: October 7, 1891, this cause having come on to be heard at a regular term of the court on final hearing, on bill, answer, replication and proofs duly taken on both sides, and having been argued by counsel for the respective parties, and the court being fully advised in the premises, it is ordered, adjudged and decreed that the Letters Patent in said complainant's bill mentioned, to-wit: Letters Patent of the United States, number 242,497, granted June 7, 1881, to Edgar A. Wright, for an improvement in cultivators, are in all respects a good and valid patent; that the said Edgar A. Wright was the first and original inventor of the improvement in said Letters Patent described and claimed; that the said complainant is entitled to the exclusive right in, to and under said recited Letters Patent, and in and to the invention and improvement secured thereby; that the said defendant, by the manufacture and sale of cultivators substantially such in construction and operation as described in said Wright Patent, and claimed in the first four claims thereof, has infringed upon the said patent, and upon the exclusive rights of the said complainant therein and thereunder, as claimed in the first four claims thereof; and that the complainant do recover of the said defendant all gains and profits by it made, and the damages sustained by complainant by reason of such infringement, as well as the costs and charges of this suit to be duly taxed; and that it be referred to E. B. Sherman, Esq., one of the masters of this court,

to ascertain the amount of such gains and profits, and of the damages sustained by the said complainant by reason of such infringement.

And further, that a writ of injunction, according to the prayer of said bill, be issued from and under the seal of this court, restraining and enjoining the defendant, its agents, employees, servants, workmen, and all others acting by and under its authority, from any further infringement of the said letters patent, and of the exclusive rights of said complainant thereunder.

And it is further ordered that the complainant, on such accounting, has the right to cause an examination of said defendant's officers, agents, employees and workmen *ore tenus* or otherwise, and also the production of the books, vouchers, documents or other papers of the defendant, and that the said defendant, by its proper officer, servant, agent or attorney, attend for such purpose before said master from time to time, as said master shall direct.

IN THE CIRCUIT COURT OF THE UNITED STATES, NORTHERN DISTRICT OF ILLINOIS.

The Eagle Manufacturing Company,
v.
The Moline Plow Company.
} *In Equity.*

June 14, 1889.

The following deposition was taken on behalf of complainant, before E. B. Sherman, Master in Chancery of the Circuit court of the United States for the Northern district of Illinois, by agreement and stipulation of counsel for the respective parties.

Present: NATHANIEL FRENCH, for complainant, and WEST & BOND, for defendant.

STIPULATION.

Stipulation.

It is hereby stipulated by and between the counsel for the respective parties to the above entitled suits, that the deposition of H. L. Brevoort, which was taken in the case of the *Eagle Manufacturing Company* v. *The Moline, Milburn & Stoddard Company* in the Circuit court of the United States for the Southern district of Iowa, may be used in evidence herein, so far as material and relevant, with the same force and effect as though taken herein. The aforesaid deposition makes reference to the deposition of W. S. Bates, also taken

in the case in the Southern district of Iowa, before mentioned, and which has also been offered in evidence herein.

Depositions and other evidence taken pursuant to agreement, at Chicago, March 1, 1888.

It is stipulated by the parties hereto, that the deposition of G. Watson French, taken in the case of the *Eagle Manufacturing Company* v. *David Bradley & Company*, pending in the United States Circuit court, for the Southern district of Iowa, Western Division, may be considered in evidence in this case, and a copy thereof may be written out and filed in this case at any time, to complete the record; continuing the said deposition the witness is asked the following questions on direct examination, by Nathaniel French:

Deposition of G. Watson French.

Q. 1. Is the defendant in this case, the Moline, Milburn & Stoddard Company, engaged in business in the state of Iowa, and if so, where, and in what business?

A. They are engaged in the sale of agricultural implements, in Des Moines, Iowa.

Q. 2. If said company sells cultivators, please state what make of cultivators they sell, if you know, and when they commenced selling the same?

A. They sell cultivators manufactured by the Moline Plow Company, of Moline, Illinois, and have sold the same previous to December 15, 1887, in the state of Iowa.

Q. 3. How long previous, do you know?

A. I do not know.

Q. 4. I will ask if you procured one of the cultivators sold by the defendant?

A. I did.

Q. 5. Have you that cultivator yet?

A. I have.

Q. 6. Did you ever show that cultivator to Cyrus Kehr?

A. Yes.

Q. 7. You may look at the cut of cultivators marked "Exhibit, Cut of Defendant's Cultivator," and state whether or not it is a correct representation of their cultivator?

A. It is.

(The cut is offered in evidence.)

Cross-Examination by Mr. Bond.

Q. 8. Have you knowledge or information as to when the defendants commenced selling machines in Iowa?

A I do not know when the defendants commenced selling machines in Iowa, except that it was previous to December 15.

Q. 9. You would have known it, would you not, if they had in any manner damaged or injured the sale of your machines?

A. The cultivator made by the Moline Plow Company has been sold in Iowa for several years, but by whom I am unable to positively say.

Q. 10. As a matter of fact, the Moline Plow Company, either by itself, its agents, or representatives, sold the same machine in Iowa as early as 1882, did they not?

A. Either in 1882 or 1883.

Q. 11. Their works are just across the river from you, are they not—that is, the works of the Moline Plow Company?

A. Yes.

Re-Direct Examination.

Q. 12. How long prior to the time you showed this machine to Mr. Kehr, did you obtain it?

A. From one to three weeks, as definitely as I can state it.

The following is the deposition of G. Watson French, in the suit of the *Eagle Manufacturing Company* v. *David Bradley & Company*, offered herein under the foregoing stipulation:

Direct Examination by Judge French.

G. WATSON FRENCH, being first duly sworn on behalf of complainant, testifies as follows:

Q. 1. State your name, age, residence and occupation?

A. G. Watson French; 30 years old; Davenport, Iowa; Vice President of the Eagle Manufacturing Company.

Q. 2. What is the capital stock of the Eagle Manufacturing Company, and in what business is it engaged?

A. $200,000; manufacturer and selling of agricultural implements.

Q. 3. Is there any implement of which you sell especially large numbers?

A. Yes, cultivators.

Q. 4. Do you sell cultivators with springs which act with increasing effect to lift the beams, as the beams are raised?

A. Yes.

Q. 5. Have you ever made, and sold in the regular course of your business to your dealers and customers, spring cultivators of the particular kinds shown in the drawings of the patent to E. A. Wright, number 242,497; I mean by that, cultivators with springs of that particular form and construction; and if you have sold such cultivators, as before stated, please mention to what extent

A. We have made and sold about fifteen to twenty thousand of said cultivators, to our regular customers in the course of our regular business.

Cross-Examination by Mr. Bond.

Q. 6. During what years or seasons did you make and sell cultivators, containing the spring shown in the complainant's patent, 242,497?

A. From 1879 to 1885.

Q. 7. Why did you quit?

A. Our superintendent decided that a spring acting on a pipe-box with projecting arm was more desirable to our company, and he changed it accordingly.

Q. 8. So far as you know, were cultivators having on then the Wright spring satisfactory to the firms that used them?

A. Yes.

Q. 9. Did you have any complaint, or know of any firm taking them off?

A. No.

Q. 10. What form of spring are you now using on your cultivators?

A. The form shown in the circular which I give now to the notary to mark for identification, marked "Circular, Golden Eagle Cultivator, G. W. French's deposition."

Q. 11. Do you consider your present machine a better one than the one shown in the Wright patent?

A. Yes.

Q. 12. Do you make any other style or kind of cultivator than the one shown in the circular just produced by you?

A. Yes, we make a tongueless cultivator and a combined riding and walking cultivator.

Q. 13. How have the sales of the lifting-spring cultivators, like those of the Wright patent, and of the circular, compared or averaged with the sales of the other forms of cultivators made and sold by your company?

(Objected to as immaterial, and not cross-examination.)

A. The sale of the spring cultivator have increased much more largely than the cultivators we made without springs.

Q. 14. How do they average as to numbers made and sold?

A. I couldn't give the exact proportion without having our books to examine.

Q. 15. Give your best estimate.

A. Ninety-five per cent of all the cultivators that we have made in the past three years have been spring cultivators.

Q. 16. How was it before you adopted the new form of spring?

A. About the same, for the two years preceding the adoption of the new spring. The sale of cultivators without springs has been growing less and less every year.

Q. 17. Do you know a man by the name of Koutz living in Scott county, Iowa?

A. Yes.

Q. 18. Dou you know of his having any trouble with the Wright spring?

A. No.

Q. 19. Do you know whether or not, your company sent him any extra springs?

A. Not that I know of.

Q. 20. Do you know whether or not he had a cultivator with the Wright spring on it?

A. He bought one from us.

Q. 21. Do you know anything of the history of that machine after it passed into his hands?

A. Some attorneys went to see the cultivator, tried to get Mr. Koutz to testify that the springs were of no benefit; that is all I know of it.

Q. 22. Don't you know that the reason he gave for his refusal was that he was a friend of the company; that they had treated them well, and he did not want to hurt them?

A. No, sir.

Re-Direct Examination.

Q. 23. While your company was engaged in making cultivators with springs, such as are shown in the drawings of the patent mentioned, did the sale of cultivators with such springs increase or decrease from year to year?

A. They increased each year.

Re-Cross-Examination.

Q. 24. Cultivators of this class were introduced by W. T. Brown, of Ohio, Deere of Moline, and possibly others before 1879, and from that date down, have not all manufacturers been advertising and canvassing for the sale of spring cultivators, and is not this the reason for increasing sales?

A. Cultivators sold by Brown, of Ohio, and Deere & Company in competition with our cultivators, did not have a spring with an increasing lifting effect and depressing effect, which our cultivator had, and which rendered them very popular with the trade. While the increase of cultivators may be due to the development in the country and the improvement in them, the increase in the sale of our cultivator we consider was due largely, if not entirely, to our peculiar spring.

Q. 25. Was not the spring which you adopted in 1885 a spring then well known to the trade?

A. No.

Q. 26. You know of the use of the spring shown in your circular exhibit before you used it on your machines, did you not?

A. Cultivators had been made previous to 1885 which had a long, upright coil spring; our spring consists of two springs to each gang, one, the long coiled spring, the other a short auxiliary spring. The short auxiliary spring was an invention new to the trade.

Q. 27. Of what use is the short spring?

A. To suspend the drag-bar while in operation in the ground, to regulate the depth of plowing and to assist in raising the gangs.

Q. 28. Is there any reverse or down pressure in the machine of the circular, when the shovels are in the ground?

A. It can be so adjusted as to give a down pressure by means of the long coiled spring.

Q. 29. Is it?

A. It is done so at the will of the operator in the field.

Q. 30. The lifting of the beam is accomplished by means of the long spring, is it not?

A. The long spring raises the beam and suspends it; the short spring can be so adjusted as to assist in raising the beam part of the way; when the greatest force is exerted by the operator, it acts.

Q. 31. The machine shown in the circular has, altogether, four springs, has it not?

A. Yes.

Q. 32. Do you understand that there are 4 springs in the machine shown in the Wright patent?

A. No.

(Complainant offers in evidence, letters patent 242,497, dated June 7, 1881, granted to E. A. Wright, and marked "Exhibit, Complainant's Patent.")

It is here stipulated and agreed that the complainant is the owner of this patent.

[Endorsed]: Filed Feby. 3, 1891.

WM. H. BRADLEY, *Clerk.*

Deposition of Cyrus Kehr.

Cyrus Kehr, being first duly sworn on behalf of complainant, testified as follows:

Direct Examination by Mr. French.

Q. 1. State your name, age, residence and occupation.

Deposition of Cyrus Kehr.

A. Cyrus Kehr; age 31 years; residence, Chicago, Illinois; occupation, solicitor of patents and mechanical expert.

Q. 2. State generally, what opportunity you have had for familiarizing yourself with mechanical questions and your experience in dealing with such questions, particularly as they arise in connection with patents for inventions.

A. During the last 8 or 9 years, I have devoted myself to the study of mechanics and patent law, and to the work of soliciting patents, and have, during said time, testified frequently as expert in patent cases.

Q. 3. Have you examined and do you understand complainant's patent, number 242,497?

A. I have examined said patent and understand the same.

Q. 4. Have you examined and do you understand the construction of a certain cultivator shown to you last December at Davenport, Iowa, by G. Watson French, and said to be a cultivator sold by the defendant?

A. I have examined said cultivator, and it was shown to me by G. Watson French at the place mentioned. I understand the construction of said machine.

Q. 5. When was that cultivator shown to you by G. Watson French?

A. On, or a day or two preceding, December 10, 1887.

Q. 6. Please look at the exhibit marked "Exhibit, Cut of Defendant's Cultivator," and state whether it is a substantially correct representation of said cultivator?

A. I think it is.

Q. 7. Directing your attention to the complainant's said patent and the invention shown and described therein, and referred to in the first four claims thereof, please state what you understand to be the invention described therein, and whether or not you find substantially the same invention in the cultivator shown by said exhibit, and give your reasons for any opinion you may express.

A. I understand said invention to consist in the combination of a cultivator frame, pivoted drag-bar or beam, and a spring, said combination being characterized by the fact that said spring is so incorporated with the cultivator as that, when the beam ascends from the working position, the bearing or connection of the spring is so changed or shifted as to produce a maintained or increased lifting effect upon the plow beam, as the latter ascends.

The inventor in his patent sets out that this combination may be effected in a variety of ways. In his drawings he shows one particular form with a modification. But in speaking of said drawings he says.

"The accompanying drawings illustrate one manner of embodying my invention."

This statement I take to be an intimation that he has other forms in view.

On page 2 of the specification, at line 120, he says:

"Among other arrangements which may be substituted for that shown, is that of having a radius bar or link introduced between the spring and beam as a substitute for the curved spring and roller."

And again, at line 99 on the same page, he says:

"While it is believed that the form of spring represented in the drawing is preferable to all others, the invention includes, as before

stated, any spring so combined with the beam or its equivalent that a greater or stronger lifting force or effect is exerted upon the beam when the latter is above the operative position than when it is in use; or, in other words, the invention includes any and all beam-lifting springs, the effect of which is lessened or avoided when the beam descends to an operative position."

Having in mind these statements and suggestions, I find on making an examination of said defendant's cultivator that it contains the frame, the drag-bar pivoted thereto, and a lifting spring combined in a manner coming within the explanations and suggestions of complainant's patent; that said spring operates to raise said drag-bar in substantially the same manner as set forth in complainant's patent.

The frame in defendant's cultivator is almost identical in form with that shown in figure 1 of the drawings of complainant's patent. It has almost identically the same form of tongue, arched axle and braces. The plow beam or drag-bar is also almost identical in form. The plow beam in defendant's cultivator is pivoted not directly to the axle, but immediately in front of it, to what is termed a pipe-box or false axle, while in figure 1 of complainant's drawing the plow beam is shown as pivoted directly to the axle. This difference I do not regard as material. The operation is the same. The coupling in each case forms a pivot upon which the plow beam turns is moving to or from the working position. From the inner end of defendant's plow beam there ascends a short arm, from the upper end of which there ascends a rod. The lower end of said rod is jointed to the upper end of the arm rising from the plow beam, while the upper end of said rod rests in a guide projecting from the arch of the axle. A coiled spring surrounds said rod and rests against the guide above and against a shoulder below. Said spring is an expansion spring, pressing against said guide and shoulder. In saying that said short arm rises from the inner end of the plow beam, I regard the fork which surrounds the pipe-box as a continuation of the beam.

When said plow beam is in the horizontal position, the short arm, which I have mentioned, stands almost in a vertical line extending through said pipe-box and said spring is in or near a vertical position. Consequently, the pressure of the spring is upon the pivot formed at the pipe-box, or said pressure is in a line which almost touches said pipe-box. Said spring can therefore exert little or no lifting effect upon said beam, notwithstanding the fact that it may exert a great pressure. When the beam ascends from the working position, the short arm which supports the spring turns forward over the pivot or fulcrum and carries with it the lower end of the rod which the spring surrounds, so that the spring no longer presses in the direction of the fulcrum, but farther and farther away from it. The spring then exerts what force it has to increased advantage. This is clearly an embodi-

ment of the principle and action set forth in complainant's patent by said four claims.

I have not overlooked the fact that in complainant's patent the drawing shows a spring which moves over a roller. Said particular spring shown in the drawing is so combined with the rest of the machine as that a change of bearing is effected when the plow beam is moved to or from the working position. Defendant does not use said roller, yet his spring operates in substantially the same manner upon the plow beam; and, as I have already stated, complainant's patent states that a roller may be dispensed with. If the roller is dispensed with, then the way is open for the use of such a coiled spring as defendant uses. Suppose we have before us a machine made in the form shown by defendant's drawing, and called a mechanic to remove the roller as indicated by the specification; the mechanic after removing the roller could use the spring in the form of a bar or blade suitably shaped or bent, and make suitable connections. Having done this with a spring in the form of a blade or bar, he will at once see that a coiled spring may as well be used.

Cross-Examination by Mr. Bond.

Q. 8. Do you understand that the suggestion in the complainant's patent that the roller may be dispensed with is a direction to re-construct the machine?

A. I understand that it is a direction to another form of embodying the complainant's invention.

Q. 9. As shown in the drawing, the roller is nothing more than an anti-friction roller, is it?

A. The roller itself acts as an anti-friction roller; the roller and its axle together from a point about which the spring turns as the plow beam moves, so as to change the direction of the line through which the spring exerts its power.

Q. 10. The Wright spring would work on the axle or spindle of the roller without the roller, the same that it does with it, would it not, with only the difference of some increase in friction?

A. Yes, I understand that if the same spring were retained without change in form, and the roller merely taken from the spindle, that then the spring would bear against said spindle and slide over and turn around the same, with merely some increase of friction.

Q. 11. You understand, do you not, that the section quoted by you, commencing with line 99 of page 2 of the specification, was intended to, and does in fact, cover any form of spring?

A. Yes, any form of spring capable of being so combined with the other parts as to operate as set forth in the patent.

Q. 12. Please explain how you can put a spring of the defendant's form into the combination of the Wright patent and make it operative?

A. I assume that the question refers to the machine shown in the drawing. With this understanding, I answer that the spring marked *d*, in figure 1, may be transformed into a rigid rod or bar, the puller removed from the spindle *b*, and a greater space made between said spindle and the rigid bar into which the spring has been transformed, and the coiled spring inserted between said spindle and bar, the upper end of the coiled spring being joined to the said spindle, and the lower end of the spring being joined to said bar in a vertical line, passing through or near the pivot of the plow beam, when said beam is in a horizontal or working position.

Q. 13. Do you understand that the spring *d*, in figure 1, is a different spring from that shown in figures 2 and 4?

A. No, I understand that said figures 2 and 4 are intended to show the same spring appearing in figure 1.

Q. 14. If you took the defendan'ts spring and placed it in the same combination and arrangement that the spring *d* is placed in, in figure 2, would you have an operative machine? Understanding, of course, that the outer end is free, as in the Wright machine.

A. The particular spring which the defendants use, placed as I understand by the question, would not, I think, answer the purpose of defendant's spring as shown in the drawing. The strain on defendant's said particular spring would then be lateral instead of axial, and I do not think said spring is strong enough to sustain the plow beam when applied in this new way. It is my opinion, however, that a coiled spring might be made of sufficient strength to take the place of the spring *d*, in figure 1, and applied in the same way. It would, of course, have to be shaped properly. While I state that

in my judgement a coiled spring might be made strong enough to be thus used, it would be difficult, and no manufacturer would be likely to use it.

Q. 15. In the form last supposed in your answer, there would be no advantage in the coiled form, would there; or, in other words, it would be better without coils, as shown in the patent, would it not?

A. Yes. I think a satisfactory spring can be made without coiling the entire length. The less coiling there is done in this particular form, the less work is required. It is to be noted, however, that the spring shown in the drawings is not without coils.

Q. 16. The specification contains the following statements, to-wit: Figure 1, line 94 — "The machine may be of any suitable character as regards general construction, that shown in the drawings being the usual and well-known form of the ordinary double-shovel wheel cultivator" And on page 2, commencing with line 125: "While the invention is designed more particularly for use in connection with wheel cultivators, it is obvious that it may be applied to various other machines containing substantially the same requirements" Would you not understand from those statements that the Wright improvement was to be applied, and the patent extend to and cover any machine for cultivating soil, or even for other purposes, that required a lifting movement up to a certain position, and returned from such elevated position to a lower working position?

A. In line 127, in speaking of the invention, the inventor says: "It is obvious that it may be applied to various other machines, containing substantially the same requirements."

By this I infer that he had in mind to apply his invention to cultivating machines comprising a frame and a pivoted drag-bar supported from said frame.

Q. 17. Why do you understand that the statement just quoted by you requires as a limitation a pivoted drag-bar?

A. Because, also, in his specification and in his drawings he shows or describes such.

Q. 18. When he says in his specification that the machine shown in the drawings is of "the usual and well-known form of the ordinary double shovel wheel cultivator," and then says: "It is obvious that it may be applied to various other machines," why do you understand that the various other machines means the one shown?

A. I do not understand that said quotation means the particular one shown.

Q. 19. Are there not various other machines, such as sulky plows, gang-plows, harrows and horse-rakes, to which the Wright improvement could be so applied?

A. There may be some forms of such machines to which the Wright invention might be applied; but I think generally such application could not be made to the kinds of machines mentioned.

Q. 20. Do you not understand from the statement of the specification which we have just been considering, that the patentee intended to have his patent cover any spring in any machine having substantially the same requirements as the one shown and described, that is, any machine requiring frequent or occasional lifting by the attendant and returning to a working position?

(Complainant's counsel objects to so much of the foregoing question as interpolates an assumed meaning for the term "containing substantially the same requirements," especially in view of the fact that the witness in his answer to cross-question 16, has given his understanding of the meaning of that phrase; and hence the question, as put, is unfair and misleading to the witness.)

A. The latter part of the question clearly assumes more for the quotation than I think it was designed to express. To further justify my position, I quote, beginning at line 7, page 1: "This invention relates to that class of machines, generally wheeled, which have vertically swinging beams or drag-bars to carry the shovels or plow points."

Q. 21. You understand, then, do you, that when the patentee says that the drawings show a machine of the form mentioned in your last answer and says his invention may be applied to "various other machines;" that "various other" means the same machine, do you?

(Counsel for complainant objects, because the question quotes only part of the phrase from the patent, and omits a part which materially qualifies, and limits the part quoted.)

(Counsel for defendant objects to this manner of instructing the witness, and insists that the quotations are fair.)

(Counsel for complainant states that he has not instructed the witness, that the witness needs no instruction, and that he only objects when, in his opinion, the question is misleading.)

(Counsel for defendant replies: "Or hurts.")

A. By "various other machines containing substantially the same requirements," the inventor means such other forms of machines, in addition to the form shown in the drawings 1, as come within the following: "Machines, generally wheeled, which have vertically-swinging beams or drag-bars to carry the shovels or plow points."

Q. 22. Is that the best answer you can make to the question?

A. I think so.

Q. 23. Do you understand that there is mechanically no difference between a structure and a requirement?

A. The question is too profound for my understanding.

Q. 24. The patentee says: "The object of the invention is to render the operation of the machine easier and less laborious to the attendant by applying springs thereto in such a manner that they will assist the operator in raising the beams and shovels attached thereto from their operative to their inoperative position, and this without having the springs exert any objectionable lifting strain when the latter are in action. To this end the invention consists in applying lifting springs in such manner that they exert upon the beams a maximum power or strain when the latter are above an operative position." Are not these points the requirements of the combination, and do such requirements necessarily refer to specific structures?

A. The requirements, if I understand the question, refer generally to the class of machines stated in the first sentence of the paragraph beginning at line 7, page 1, of the specification.

Q. 25. If that is your understanding, then why is not the patent limited to the structures shown and described?

A. It is limited to the structures mentioned in the sentence to which I have just referred, namely to "machines, generally wheeled, which have vertically-swinging beams or drag-bars to carry the shovels or plow points."

Q. 26. What are the requirements or purposes of the complainant's combination in that kind of a machine?

A. Does the question mean a machine having a vertically-swinging beam or drag-bar to carry the shovels or plow points?

Q. 27. Is not that the kind of a machine which you just stated the patent was limited to?

A. It is.

Q. 28. That is the machine the question referred to.

A. The requirement is to combine with the frame of the machine and said drag-bar, a spring which shall exert little or no lifting effect when the beam is in the working position, and which shall exert a maintained or increased lifting effect when beam is elevated or turned upward upon its pivot. This is the requirement or purpose, and the inventor fulfilled said requirement by making the kind of combination which I explained in direct examination.

Q. 29. Of what practical use or benefit is all of that?

A. All of what I have said.

Q. 30. Yes, of that mechanical requirement.

A. To produce a good machine.

Q. 31. Good in what respect?

A. One — it is easily operated by the plowman.

Q. 32. Or, in the words of the specification, "to render the operation of the machine easier and less laborious to the attendant," is it not?

A. Yes, that is evidently the object that the inventor had in view.

Q. 33. Then why may not the invention of the patent be used in any machine which would render the operation of the machine easier and less laborious to the attendant when the operators are cultivating the soil?

A. All machines or apparatus for accomplishing a certain result need not be alike. To illustrate: a fowl's head may be removed by the use of a gun, or it may be removed by the use of some cutting instrument. In each case, the object or requirement is to remove the head. If the object be to cultivate the soil, two, or several machines wholly distinct, may be used.

Q. 34. If the object was to kill the chicken, it would be a dead chicken either way, would it not?

A. Yes, if the head was removed.

Q. 35. The labor of the attendant, which the complainant's combination is supposed to relieve, is the lifting of the plow in passing obstructions, hills out of line, or turning at row ends, is it not?

A. It is.

Q. 36. And in cultivating corn, planted by a planter in the prairie soils of Illinois and Iowa, in which stones or grubs do not occur, would not the principal labor of an attendant in lifting the plows of the machine, be principally at the row ends?

A. In plowing in the direction in which the planter moved, the hills of corn would be in a straight line, hence the plow beams or shovels would not have to be lifted to avoid hills of corn out of line, so long as the horses drew the cultivator directly over the row. In plowing cross-wise of the direction in which the planter moved, many of the hills would likely be more or less out of line, so that the shovels would require lifting to avoid said hills. In the prairie soil of Illinois and Iowa, where there are no stones or grubs, there are often other obstructions in the form of corn stalks and roots of a preceding season. These become engaged in the shovels to an annoying extent, and frequently require the shifting and lifting of the shovels to free the latter.

Q. 37. Why do you call the solid rock-shaft in defendant's machine a pipe-box?

A. I call it a pipe-box because I understand that is the name applied to it by cultivator manufacturers. I understand that a sleeve surrounding the axle to which the beam is coupled, in some machines, is called a pipe-box, and that when a false bar was placed in front of the axle to form a connection for the plow-beam, it was still termed a pipe-box, although it was no longer a pipe or sleeve.

Q. 38. In the defendant's machine, the structure upon which the spring is placed is what is commonly known by the names of toggle-joint, knee joint or knuckle-joint, is it not?

A. Yes, the spring extends down to such a joint.

Q. 39. The operation of the arm on the rock-shaft in the defendant's machine is that of a crank-arm advancing toward or receding from the dead center or neutral line, is it not—the spring itself with its contained rod acting as the pitman in this form in defendant's machine?

A. That depends upon the breadth of meaning given to the term crank. It is to be noted that the arm ascending upward from the beam to which the spring is coupled by means of the rod passing through it, moves through only a small portion of the arc of a circle, and that at one limit of its movement it is substantially on the dead center, and there stops, while at the other limit of its movement it is away from the dead center. It is my impression that an oscillating crank is usually moved through an arc between the points which we call the dead center, and that the aim is to avoid the dead center.

Q. 40. A rocking device, rocked by an arm having a crank-pin may have a crank action, may it not, without revolving in a complete circle?

A. It may.

Q. 41. In the complete revolution of a crank there are two dead points or centers, and two points of greatest power, are there not?

A. There are.

Q. 42. Is not the action of the spring in defendant's machine decreased in its power as the arm of the rock-shaft approaches the neutral line, and increased as it passes away from said line to the extent of its limit in the machine?

A. The lifting effect of the power is decreased when the spring is on, or nearly on the neutral line, and is increased as it recedes toward its farther limit.

Q. 43. Do you understand that the first four claims of complainant's patent are substantially alike?

A. I understand that they express some differences, and yet it might be said that they are substantially alike.

Q. 44. Do you understand that the complainant's patents instructs anyone how to construct a machine with a radius-bar or link as a substitute for the curved spring and roller?

A. I understand that the patent states that the radius-bar may be substituted for the roller, and that it assumes that a mechanic skilled in the art will understand how to make this modification, after becoming familiar with the invention, as set forth in the patent.

Q. 45. You do understand, do you not, that the specification leaves it to the skill of the constructor, and that it does not explain or describe *how* it is to be done?

A. Yes, I understand the embodying of this modification is left to the skill of the constructor, aided by the explanation of the invention in the patent. The details for embodying the modification are not set out in terms.

(Complainant offers in evidence the full-sized machine mentioned in the deposition of G. Watson French, and which is marked by the witness, "Exhibit, Defendant's Cultivator.")

(Complainant offers in evidence certified copy of the decree, and the Exhibits B1 and B2 therein mentioned, which said decree is rendered in the case of the *Eagle Manufacturing Company* v. *The Davenport Plow Company* in the Circuit court of the United States for the Southern district of Iowa, Eastern Division, the same being marked "Exhibit, Complainant's Davenport Decree and Exhibits.")

(Counsel for defendant objects to the introduction of the Exhibits B1 and B 2 as a part of this record.)

(The complainant thereupon announces that it closes its *prima facie* case, and notifies counsel for defendant to proceed with all due diligence to take its testimony in defense, in order that the complainant may have time to take rebutting evidence with reference to the hearing at the May term of court.)

[Endorsed]: Filed Feby. 3, 1891.

WM. H. BRADLEY, *Clerk.*

"Complainant's Exhibit Moline Final Decree."

In the Circuit Court of the United States, for the Southern District of Iowa.

Central Division.

The Eagle Manufacturing Company,
v.
The Moline, Milburn & Stoddard Co. } *No. 2,224. Eq.*

Final Decree.

Final Decree.

This cause came on for hearing on October 15, 1889, being the first day of the May term of said court, on the report of the master, and thereupon, in addition to the matters hereinbefore adjudged and decreed in the decree hereinbefore rendered on May 28, 1888, it is now ordered, adjudged and decreed that the report of the master be confirmed, and that the complainant have and recover of the defendant the sum of one cent nominal damages, and the costs of the reference to the master to be taxed.

(Signed): J. M. Love.

[Endorsed]: No. 2,224, Eq. *The Eagle Mfg. Co.*, v. *The Moline, Milburn & Stoddard Co.* Decree filed Oct 15, 1889.

Ed. R. Mason, *Clerk.*

IN THE CIRCUIT COURT OF THE UNITED STATES, FOR THE SOUTHERN DISTRICT OF IOWA.

CENTRAL DIVISION.

I, E. R. Mason, clerk of said court, do hereby certify that the transcript to which this certificate is attached contains a full, true and complete copy of the decree in a certain cause in said court adjudicated, wherein The Eagle Manufacturing Company were plaintiff, and The Moline, Milburn and Stoddard Co., defendant, as full, true and complete, as the original of the same now remains on file and of record in my office.

In testimony whereof, I hereunto subscribe my name and affix the seal of said court at my office in the city of Des Moines, in said district, this 17th day of October, A. D. 1889.

[SEAL] E. R. MASON,

Clerk U. S. Circuit Court, Southern Dist. of Iowa.

[Endorsed]: Filed Feby 3, 1891.

WM. H. BRADLEY, *Clerk.*

Afterward, to-wit: On the eighth day of October, 1891, came the Moline Plow Company, by its solicitors, and filed in said clerk's office its petition for appeal and assignment of errors in said entitled cause, which said petition and assignment of errors are in the words and figures following, to-wit:

PETITION FOR APPEAL.

UNITED STATES CIRCUIT COURT,
NORTHERN DISTRICT OF ILLINOIS.

The Eagle Manufacturing Company,
v.
Moline Plow Company.
In Equity.

Petition for appeal, filed Oct. 8, 1891.

And now comes the Moline Plow Company, defendant in the above entitled cause of action, by its solicitor, and prays for an appeal in said cause of action to the United States Court of Appeals for the Seventh Circuit, and for a supersedeas of the injunction granted in said cause in and by the decree entered therein October 7, A. D. 1891, and makes the following assignment of errors or reasons for appeal in support thereof:

ASSIGNMENT OF ERRORS.

1. That the court erred in finding the complainant's patent valid. Assignment of Error.

2. The court erred in not finding the patent sued on invalid for want of patentable novelty or invention.

3. The court erred in finding the patent sued on to be valid notwithstanding a prior patent showing the same machine, granted to the same patentee December 10, A. D. 1879.

4. The court erred in finding the patent sued on valid in view of the prior art.

5. The court erred in holding that the patent sued on was valid, and was unlimited as to mechanical constructions.

6. The court erred in holding that the defendant's machine infringed.

7. The court erred in not finding that Charles A. Hague invented and constructed the machine manufactured by the defendant, prior to the invention by E. A. Wright of the machine shown and described in the patent sued on.

8. The court erred in not finding that Henry N. Dalton invented and constructed substantially the same machine manufactured by the defendant, prior to the invention by E. A. Wright of the machine shown and described in the patent sued on.

9. The court erred in holding that the defendant was estopped by the proceedings in the Eighth Circuit from making any defense in this cause upon the merits.

10. The court erred in holding that the defendant was estopped by the proceedings in the Eighth Circuit from making a new defense in this cause.

11. The court erred in holding that the defendant was in this suit estopped from setting up or proving additional defenses to those interposed at the prior suit in the Eighth Circuit.

12. The court erred in holding that all the defenses urged in this suit were anticipated and cut off by the decree in the Iowa case.

Wherefore, the defendant says, that in the record of the said cause there is manifest error, and prays that an appeal be allowed it and a supersedeas be granted, as above prayed.

MOLINE PLOW CO.,
By BOND, ADAMS & PICKARD,
Its Solicitors.

[Endorsed]: Filed Oct. 8, 1891.

WM. H. BRADLEY, *Clerk.*

On the same day, to-wit: On the eighth day of October in the adjourned October term of said court, 1891, in the record of the proceedings thereof in said entitled cause before Honorable Henry W. Blodgett, District Judge, is the following entry, to-wit:

ORDER.

The Eagle Manufacturing Company,
v.
The Moline Plow Company. } *In Chancery.*

Order, entered Oct. 8, 1891.

On prayer of the defendant an appeal is allowed it to the United States Circuit court of Appeals for the Seventh circuit, from the decree herein, and said appeal is made a supersedeas on condition that said defendant, within ten days, file an appeal bond in the penal sum of ten thousand dollars, with surety to be approved by one of the Judges of this court, conditioned as provided in rule 13 of said Circuit court of Appeals.

Afterward, to-wit: On the twenty-sixth day of October, 1891, there was filed in said clerk's office an appeal bond in said entitled cause, which said appeal bond is in the words and figures following to-wit.

APPEAL BOND.

Appeal Bond, filed Oct. 26, 1891.

Know all men by these presents, that we the Moline Plow Company, as principle, and Andrew Friberg as surety, are indebted to the Eagle Manufacturing Company in the penal sum of ten thousand dollars ($10,000) good and lawful money of the United States, for the payment of which well and truly to be made we bind ourselves, our heirs, executors and administrators, jointly and severally, by these presents.

In testimony whereof, the said Moline Plow Company has caused these presents to be signed by its president and its corporate seal to be affixed hereto, and the said Andrew Friberg has hereunto affixed his hand and seal this 17th day of October, 1891.

The condition of the above obligation is such, that, whereas, in a cause now pending in the Circuit court of the United States, in and for the Northern district of Illinois, wherein the said The Eagle Manufacturing Company was complainant and the said Moline Plow Company was defendant, a decree was entered on the seventh day of October, A. D. 1891, by the Honorable Henry W. Blodgett, against the said Moline Plow Company defendant, and in favor of the Eagle Manufacturing Company complainant, among other things enjoining the said defendant, as therein set forth; and whereas, the said Moline Plow Company has prayed an appeal from said decree to the United States Circuit court of Appeals for the Seventh circuit, and that a supersedeas be granted in said cause pending said appeal, which said appeal has been allowed and said supersedeas granted.

Now therefore, if the said Moline Plow Company shall well and truly prosecute its said appeal with effect, and shall answer to the said The Eagle Manufacturing Company all damages and costs by the said The Eagle Manufacturing Company sustained in case it

the said Moline Plow Company shall fail to sustain its said appeal, then and in such case the above obligation is to be void; otherwise to be and remain in full force and effect.

[SEAL] MOLINE PLOW CO.,

S. W. WHEELOCK, *President.*

A. FRIBERG. [SEAL]

Approved: H. W. BLODGETT, *Judge.*

[Endorsed]: Filed Oct. 26, 1891.

WM. H. BRADLEY, *Clerk.*

Afterward, to-wit: On the seventh day of November, in the adjourned October term of said court, 1891, in the record of the proceedings thereof in said entitled cause, before Honorable Henry W. Blodgett, District Judge, is the following entry, to-wit:

ORDER.

The Eagle Manufacturing Company,
v.
The Moline Plow Company. } *In Chancery.*

Order, entered Nov. 7, 1891.

On motion, it is ordered that the time for completing the record on appeal herein be extended thirty days.

NORTHERN DISTRICT OF ILLINOIS, } ss.
NORTHERN DIVISION. }

Clerk's Certificate.

I, William H. Bradley, clerk of the Circuit court of the United States for said Northern district of Illinois, do hereby certify the above and foregoing to be true and correct copies of the opinion of Judge Blodgett, filed July 13, 1891, of the decree entered of record October 7, 1891, of the stipulation dated June 14, 1889, of the depositions of G. Watson French, Cyrus Kehr and Complainant's Exhibit, Final Decree filed February 3, 1891, of the petition for appeal and assignment of errors filed October 8, 1891, of the order entered of record October 8, 1891, of the appeal bond filed October 26, 1891 and of the order entered of record November 7, 1891, in said court, in the cause wherein The Eagle Manufacturing Company is complainant and The Moline Plow Company is defendant as the same appear from the records and files of said court now remaining in my custody and control.

In testimony whereof I have hereunto set my hand and affixed the seal of said court at my office in Chicago in said district, this eighteenth day of December, 1891.

[SEAL]

WM. H. BRADLEY,
Clerk.

UNITED STATES CIRCUIT COURT, NORTHERN DISTRICT OF ILLINOIS.

The Eagle Manufacturing Company,
v.
Moline Plow Company. } *In Equity.*

STIPULATION.

Stipulation.

It is hereby stipulated and agreed by and between the parties in this cause, by their respective solicitors, that this case was tried upon substantially the same evidence and upon the same facts as the case of *The Eagle Manufacturing Company* v. *The David Bradley Manufacturing Company*, in the Circuit court of the United States, for the Northern district of Illinois, and that the record in this case is the same as that in the case last above mentioned, with the following exceptions:

First: That the answer of the defendant herein contained in place of the correspondingly numbered clauses of the answer of The David Bradley Manufacturing Company, the following clauses:

> Sixth: This defendant, further answering, admits that the cultivators sold by the said Moline, Milburn & Stoddard Company were made by this defendant, under and in adcordance with Letters Patent of the United States, No. 259,626, dated June 13, 1882, to Edgar A. Wright, and No. 266,123, dated October 17, 1882, to W. Evans.

Fifteenth: This defendant, further answering, avers that the cultivators manufactured and sold by it, and which, it is charged, are in infringement of the rights of the complainant under said Letters Patent No. 242,497, were manufactured under and accordance with said Letters Patents of the United States, No. 259,626, dated June 13, 1882, to Edgar A. Wright, and No. 266,123, dated October 7, 1882, to W. Evans, both of which letters patent this defendant has the right to use.

Second: That in addition to the patent exhibits introduced in evidence in behalf of the defendant, The David Bradley Manufacturing Company, there was offered in evidence in behalf of the defendant herein the following patents:

No. 222,391, dated December 9, 1879, granted to J. M. Elder, for cultivator, and the same was marked "Defendant's Exhibit Elder Patent, H. T. J., N. P." And that, as defendant's patents, in place of Letters Patent No. 241,123, dated June 21, 1881, granted to Charles A. Hague, and No. 270,629, dated January 16, 1883, granted to Byron C. Bradley, the defendant offered in evidence Letters Patent No. 259,626, dated June 13, 1882, granted to E. A. Wright, and No. 266,123, dated October 17, 1882, granted to Wm. Evans.

Third: That in place of interrogatories 15 to 17, both inclusive, and the answers thereto, in the deposition of William S. Bates, taken in the case of *The Eagle Manufacturing Company* v. *The David Bradley Manufacturing Company*, there are, in the deposition of the said William S. Bates, taken in this cause, the following interrogatories and answers thereto:

Int. 15. Have you examined, and do you understand, the defendant's Exhibit Elder patent?

A. I have examined it, and believe I understand it.

Int. 16. State generally what construction and arrangement of spring you find shown and described in said patent.

A. The Elder patent has a cultivator of the ordinary type. Near the front end of the beam is an arm projecting upward

and jointed to a rod which extends in the same general direction through an eye secured to the axle. Upon this rod is a spring acting at its upper end against the eye, and at its lower end against a shoulder on the rod. The spring is a spiral spring under compression, and tends to force the rod downward. The rod and the arm form a toggle which is about at its dead point when the beam is down. When the beam is raised slightly, the joint of the toggle is thrown forward of its dead point, and the spring acts with an increasing leverage to raise the beam. The effect of the spring upon the beam is therefore an increasing one as the beam rises.

Int. 17. Do you understand the construction and operation of the defendant's machine?

A. I do.

Int. 18. State whether or not, in so far as the parts are shown in the defendant's exhibit, Evans patent, No. 256,123, the spring part of the defendant's machine is substantially as shown in said Evans patent.

A. It is.

Int. 19. Please compare the defendant's machine with the machine shown and described in the complainant's Wright patent in respect to the combinations claimed in the first four claims thereof, and state whether or not you find embodied in the defendant's machine, in form or in substance, the subject matter of said four claims, or either of them, and give your reasons for any opinion or opinions you may express.

A. I have made the comparison requested. The defendant's machine does not contain, either in form or substance, the subject matter of the first four claims of the Wright patent sued on. My reasons for this conclusion are as follows:

The Wright patent shows and describes a cultivator of the ordinary form provided with a spring of peculiar construction and operation. This spring consists of a long curved portion attached at one end to either the beam or the axle, and provided with a coil at the point of attachment. On the other member of the machine is a friction roller; the curved portion of the spring passes under this roller, and bears against it, so as to have a lifting effect upon the beam. As the beam is

raised the spring rolls along the roller, and is thus shortened and consequently acts with increased force upon the beam. The first claim of the patent is for the combination of this beam and spring in a cultivator. The second claim is for the same combination in a wheeled cultivator. The third claim is for the combination of the beam and spring with a wheeled frame, and the fourth claim is for the combination of the beam and spring with a shifting or changing bearing.

In the defendant's machine I find nothing of this sort. In the defendant's machine the beam is secured to a short rock-shaft which turns as it rises and falls. At one end of this rock-shaft is an arm extending upward, and to the top of this arm is jointed a rod which extends upward through an eye attached to the axle. There is a spring on the rod which bears at its upper end against the eye, and at its lower end against a shoulder on the rod. The spring is a spiral spring, and is under compression, and tends to force the rod downward. The rod and the arm constitute a toggle, which is about at its dead point when the beam is down. When the beam is raised the joint of the toggle is thrown forward, and the spring acts with a constantly increasing leverage to raise the beam. The spring itself loses force as the beam rises.

Comparing this machine with the Wright, we see that its spring is of an entirely different form; furthermore, the Wright spring is shortened as the beam rises, and consequently acts with increased force; whilst the defendant's spring is lengthened as the beam rises, and acts with decreased force. The defendant's machine has no friction-roller, and no shifting bearing for the spring. The defendant's machine is much more like the Elder patent than it is like the Wright. It is for these reasons, namely, that the defendant's spring is of different construction, that its operation is different, that it loses force as the beam rises instead of gaining it, and that it has no shifting bearing, that I say it does not contain the inventions of the Wright patent sued on.

Int. 20. You have already stated the principle upon which the spring in a machine of the complainant's Wright patent acts, and also the operation of the spring action in the defendant's machine. Please restate the principle upon which the springs of the two machines act, and whether or not the spring action of either of them operates upon the principle of the Dalton spring, and state your reasons.

A. The Wright spring acts by a shortening of the active portion of the spring, thus giving the spring increased force as the beams rise, the weight of the beams being carried by the spring when up as well as when down. In the defendant's machine, the operation is that of a crank, the effect of the spring increasing as the crank approaches its right angular position. The weight of the beams comes more and more upon the spring as the crank-arm is turned by the lifting of the beams. In this the defendant's machine is like the Dalton, which is also a crank-arm machine, and in which the weight of the beams is gradually transferred from the spring to the axle as the crank assumes its upright position and raises the beam.

It is further stipulated and agreed in addition to the foregoing, that the said record shall include the following as portions of complainant's record herein:

Fourth: Exhibit Defendant's Cultivator.

Fifth: A transcript of the final decree in the case of the same *Complainant* v. *The Moline, Milburn & Stoddard Company*, No. 2,224, in Equity, in the Circuit court of the United States for the Southern district of Iowa, Central Division, the same being marked "Complainant's Exhibit Moline Decree."

Sixth: The stipulation contained in the complaint of the same *Complainant* v. *The David Bradley Manufacturing Company*, appealed herewith, as said stipulation is found in the record of testimony taken before E. B. Sherman, Esq., under date of June 14, 1889, was also made in connection with the taking of the same testimony herein, the name of the Iowa defendants, "The Moline, Milburn and Stoddard Company" being substituted for the name "David Bradley and Company," and such stipulation so modified, shall be a part thereof.

Seventh: A transcript of the admission made and filed herein, and reading as follows:

"For the purpose of evidence to be used by the complainant as a part of its proofs in this cause, the defendant admits the following facts:

"In the suit pending in the Circuit court of the United States for the Southern district of Iowa, wherein The Eagle Manufactur-

ing Co. is complainant, and The Moline, Milburn & Stoddard Co. defendant, and which suit was brought to restrain the infringement of the letters patent in suit herein, the defendant in this cause, The Moline Plow Co., employed counsel, took charge of and conducted the defense of said suit in the name of the said Moline, Milburn & Stoddard Company, and paid the expenses thereof. This was done by the defendant herein, the same as it would be done by it for any agent, branch house or customer engaged in selling implements purchased of this defendant, if sued for infringement of a patent on account of selling such goods.

"Signed this 9th day of October, 1889.

WEST & BOND,
Solicitors for Defendant."

Eighth: A transcript of the opinion of the court and of the final decree herein.

Ninth: A transcript of the depositions of G. Watson French, as taken in the case of the same *Complainants* v. *The Moline, Milburn & Stoddard Company*, at Chicago, March 1, 1888, as found in the printed record of said case as offered in evidence herein, commencing on page 7, also the deposition of the same witness stipulated therein, commencing on page 9 thereof, as also the deposition of Cyrus Kerr as found therein, commencing on page 14 thereof, together with the exhibits therein referred to, and not elsewhere duplicated in this or in the Bradley case.

Tenth: It is further stipulated and agreed that this stipulation, with exhibits of the Letters Patent herein referred to, shall, with the record in the case of *The Eagle Manufacturing Company* v. *The David Bradley Manufacturing Company*, be and constitute the record in this cause.

Eleventh: And it is further stipulated that the record so made constituted in substance and as to all matters at issue therein, the record in the case of the same *Complainant* v. *Moline, Milburn & Stoddard Company*, No. 2,224, in Equity, in the Circuit court of the United States, for the Southern district of Iowa, Central Division, except so much and such part thereof as relates to an alleged prior construction and use by Charles A. Hague and by the Bradley's of the cultivator referred to in Hague's testimony, and the alleged prior construction and use by H. N. Dalton.

Twelfth: It is further agreed that in case it should be found at the hearing before the Appellate court that any record or exhibit forming a part of the case when on hearing in the court below, and material to any of the issues therein, has been omitted, the party desiring the use thereof, may, under suggestion of diminution of record, produce and use the same, either by original or duly certified copy, with like effect as if the same were included in this stipulation.

It is further agreed that this stipulation may be filed *nunc pro tunc* as of a date within the time provided for by the rules of the court, and with like effect.

BOND, ADAMS & PICKARD,
Solicitors for Appellant, The Moline Plow Co.

GEORGE H. CHRISTY.
Solicitor for Eagle Mfg. Co.

[Endorsed]: Filed December 21, 1891.

OLIVER T. MORTON, *Clerk.*

MONDAY, December 7, 1891.

The folllowing order is entered by direction of

Honorable HENRY BLODGETT,
District Judge.

The Eagle Manufacturing Company,
vs.
The Moline Plow Company.

Appeal from the Circuit Court of the United States in and for the Northern District of Illinois.

Upon motion of the complainant it is hereby ordered that the time for the complainant to file its record in the above-entitled cause is hereby extended twenty days from this date.

MONDAY, June 12, 1892.

Present: Honorable JOHN M. HARLAN,
Circuit Justice.
Honorable WALTER Q. GRESHAM,
Circuit Judge.
Honorable WILLIAM A. WOODS,
Circuit Judge.

26. The Moline Plow Company,
vs.
The Eagle Manufacturing Company.

It is ordered by the court that the hearing of this cause be, and it is hereby, continued until the next term.

SATURDAY, October 1, 1892.

Present: Honorable WALTER Q. GRESHAM,
Circuit Judge.
Honorable WILLIAM A. WOODS,
Circuit Judge.
Honorable JAMES G. JENKINS,
District Judge.

26. The Moline Plow Company,
vs.
The Eagle Manufacturing Company.

It is ordered by the court that this cause be, and is hereby, set down for hearing for the 6th day of October, 1892.

THURSDAY, October 6, 1892.

Present: Honorable WALTER Q. GRESHAM,
Circuit Judge.
Honorable WILLIAM A. WOODS,
Circuit Judge.
Honorable JAMES G. JENKINS,
District Judge.

26. The Moline Plow Company,
vs.
The Eagle Manufacturing Company.

Now this day came the parties by their counsels and this cause having been partly heard upon the printed record and briefs of counsel and upon oral argument of counsel the further hearing thereof is postponed until to-morrow morning.

FRIDAY, October 7, 1892.

Present: Honorable WALTER Q. GRESHAM,
Circuit Judge.
Honorable WILLIAM A. WOODS,
Circuit Judge.
Honorable JAMES G. JENKINS,
District Judge.

26. The Moline Plow Company,
vs.
The Eagle Manufacturing Company.

Now, again, came the parties by their counsel this day and this cause having been heard to conclusion upon the printed record and briefs of counsel and upon oral arguments of counsel the court takes this matter under advisement.

FRIDAY, October 6, 1893.

Present: Honorable WILLIAM A. WOODS,
Circuit Judge.
Honorable JAMES G. JENKINS,
Circuit Judge.

26. The Moline Plow Company,
vs.
The Eagle Manufacturing Company.

An appeal from the Circuit Court of the United States for the Northern District of Illinois.

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Northern District of Illinois and was argued by counsel. On consideration whereof it is now here ordered, adjudged, and decreed by this court that the decree of the said Circuit Court in this cause be, and the same is hereby, affirmed with costs.

FRIDAY, December 8, 1893.

Present: Honorable WILLIAM A. WOODS,
Circuit Judge.
Honorable JAMES G. JENKINS,
Circuit Judge.

26. Moline Plow Company,
vs.
Eagle Manufacturing Company.

It is ordered by the court that the "petition for re-hearing" in this cause be, and the same is hereby, overruled.

UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

No. 26.—OCTOBER SESSION, 1892.

The Moline Plow Company,
Appellant,
vs.
The Eagle Manufacturing Company,
Appellee.

On appeal from the Circuit Court of the United States for the Northern District of Illinois.

Before GRESHAM and WOODS, Circuit Judges, and JENKINS, District Judge.

JENKINS, *District Judge.*

This case differs in no essential particulars from that of *David Bradley Manufacturing Company*, appellant, *vs. The Eagle Manufacturing Company*, herewith decided. It presents the same questions and is controlled by the same rules of law. The decree is, therefore,

Affirmed.

Filed October 6, 1893.

UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

I, Oliver T. Morton, clerk of the United States Circuit Court of Appeals for the Seventh Circuit, do hereby certify that the foregoing pages contain a true copy of the transcript of the record as brought to this court by an appeal and the proceedings in this court in the case of The Moline Plow Company *vs.* The Eagle Manufacturing Company, No. 26, October Term, 1891, as the same remains upon the files and records of said United States Circuit Court of Appeals for the Seventh Circuit.

In testimony whereof I hereunto subscribe my name and affix the seal of said United States Circuit Court of Appeals for the Seventh Circuit at the city of Chicago this 11th day of January, A. D. 1894.

OLIVER T. MORTON,
Clerk of the United States Circuit Court of Appeals for the Seventh Circuit.

UNITED STATES CIRCUIT COURT OF APPEALS.

SEVENTH CIRCUIT.

No. 22.—OCTOBER SESSION, 1892.

David Bradley Manufacturing Company, *Appellant*, v. The Eagle Manufacturing Company, *Appellee.*	On Appeal from the Circuit Court of the United States, for the Northern District of Illinois.

Before GRESHAM and WOODS, Circuit Judges, and JENKINS, District Judge.

STATEMENT OF THE CASE.

The appellee, on the 11th day of June, 1888, filed its bill in the court below to restrain the alleged infringement by the present appellant of letters patent of the United States, No. 242,497, dated the 7th day of June, 1881, issued to Edgar A. Wright for improvements in cultivators.

The bill, besides the usual averments in such suits, charged that on December, 1887, the complainant (the present appellee)

"commenced suit, by bill in chancery, against David Bradley & Co., in "the Circuit Court of the United States for the Southern District of "Iowa, to restrain the said David Bradley & Co. from infringing the "aforesaid letters patent. That the said David Bradley & Co. is and "was a branch house of the David Bradley Manufacturing Company, "the defendant herein, and was engaged in selling the identical cultivators "manufactured by the defendant herein; that the defendant herein under-"took and managed the defense of said suit against its branch house, "employing counsel for that purpose and conducting the defense, but it "conducted the defense in the name of the said branch house, the defend-"ant named of record. That the defendant herein, answering said bill "in the name of the said branch house, denied the validity of said letters "patent and any infringement thereof, to which answer a replication was "filed by your orator, and thereupon your orator and the defendant pro-"ceeded to take and took their respective proofs, and the same having

" been taken, the said cause was heard on final hearing at the May term " of said court at Des Moines, A. D. 1888. And the said court having " considered the proofs and the arguments of counsel did adjudge and " decree that the said David Bradley & Co. had infringed the said letters " patent, and did enjoin the aforesaid David Bradley & Co. from further " infringement thereof, which said decree remains in full force and unre- " versed; all of which proceedings and things will more fully appear by " a certified copy of the records of said court, which your orator is ready " at any time to produce in court as may be directed, and your orator " attaches hereto a certified copy of said decree marked 'Exhibit C.'

" And your orator further shows that the cultivators sold by the said " David Bradley & Co. were made by the defendant herein under letters " patent of the United States, No. 243,123, to C. A. Hague, dated June " 21, 1881, and No. 270,629, to B. C. Bradley, January 16, 1883, which " said patents were issued to the Furst and Bradley Manufacturing Com- " pany as assignee of said Hague and Bradley, and passed to the defend- " ant herein, the successor of the said Furst & Bradley Manufacturing " Company. The said cultivators as made by the defendant are correctly " shown by the drawings in the said letters patent to said B. C. Bradley."

The decree referred to in the bill as "Exhibit C" is as follows:

" This cause came on to be finally heard upon the pleadings and " proofs and was argued by counsel for the respective parties, and the " pleadings and proofs having been duly considered, it is hereby, this " 23d day of May, 1888, ordered, adjudged and decreed as follows, viz:

" The letters patent referred to in complainant's bill being letters " patent of the United States, granted unto Edgar A. Wright, for im- " provements in cultivators, No. 242,497, and dated June 7, 1881, is a " good and valid patent, and that the said Edgar A. Wright was the first " and original inventor of the improvements therein described and claimed, " and that the said complainant had at the commencement of this cause a " good and legal title to said letters patent No. 242,497, as averred in " complainant's bill, and that the said defendant has infringed the said " patent, and upon the exclusive rights of the complainant under the " same, as claimed in the first four claims of said patent.

" And it is further ordered, adjudged and decreed that the defendant " above named, its servants, agents, operatives and workmen, each and " every one of them, be, and they are, perpetually enjoined and restrained " from either directly or indirectly making, using or selling to others to " be used, cultivators constructed and operated in the manner and upon " the principle described in said letters patent of the United States No. " 242,497.

" And it is further ordered, adjudged and decreed that the com- " plainant recover of the defendant the profits which it has received or " made or which have accrued to it by the use or sale of the improvements " described and secured by said letters patent at any and all times since

" June 7, 1881, and also the damages which the complainant has sus-
" tained thereby.

" And as it does not appear to the court what said profits and dam-
" ages are, it is further ordered, adjudged and decreed that this cause be
" referred to George F. Henry, Esq., a master of this court, to take and
" report to the court an account of the profits which the defendant has
" received, or which has arisen, or accrued to it from the use or sale of
" said improvements, and to ascertain and report the damages which the
" complainant has sustained thereby since June 7, 1881, from the papers
" and evidence in the cause, and from any evidence which either party
" may produce before him of the same; and, when he shall have taken
" an account of said profits and assessed said damages, he shall return the
" same to this court for further action in the premises. And it is further
" ordered, adjudged and decreed that the complainant on such accounting
" has the right to cause an examination of the officers, agents and em-
" ployes of the defendant *ore tenus* or otherwise, and also the production
" before said master at such time as said master may order of the books,
" vouchers, and documents of the defendant, and that the officers of said
" defendant attend before said master from time to time within this dis-
" trict as said master shall direct.

" And it is further ordered that the question of increase of damages,
" and all other questions, be reserved until the coming in of the master's
" report.

" And it is ordered that the parties and master may apply on the
" foot of this decree for such other and further order of instruction as
" may be necessary.

" And it is further ordered, adjudged and decreed that the complain-
" ant recover of the defendant the costs of this suit to be taxed."

The answer of the defendant (the present appellant) contains the following admissions respecting such charges:

" Fourth. This defendant, further answering, admits that a suit
" was commenced by the Eagle Manufacturing Company, the complain-
" ant herein, against David Bradley & Co., in the Circuit Court of the
" United States, for the Southern District of Iowa, substantially as in said
" bill alleged. They admit that said David Bradley & Co. was and is a
" separate corporation, and in part a branch house or agency of this
" defendant, and was engaged in selling, with other machinery, culti-
" vators manufactured by this defendant.

" They admit that said suit was to a certain extent defended by this
" defendant. They admit that pleadings were filed and proofs taken, as
" set forth in said bill.

" Fifth. This defendant, further answering, admits that said last
" named suit was heard at the time and place alleged in said bill, and
" that a decree was rendered adjudging that said David Bradley & Co.
" had infringed the said letters patent No. 243,497, and that the said

"David Bradley & Co. was enjoined from further infringement thereof, "but this defendant avers that in said cause the finding of the court was "against the defendant largely, if not wholly, by reason of the said court "not understanding the operation of the machine shown in one of the "patents set up as anticipation the supposed invention of complainant's "patent, to wit: The Dalton patent of 1869, and this defendant has rea- "son to believe, and does believe, that if the court had fully understood "the machine of said patent the finding and decree would have been "different.

"Sixth. This defendant, further answering, admits that the culti- "vators sold by the said David Bradley & Co. were made by this "defendant under, and in accordance with, letters patent of the United "States, No. 243,123, dated June 21, 1881, to C. A. Hague, and No. "270,629, dated January 16, 1883, to B. C. Bradley."

There was given in evidence in this suit the following admission by the defendant:

"In the suit pending in the Circuit Court of the United States, for "the Southern District of Iowa, wherein the Eagle Manufacturing Co. is "complainant, and David Bradley & Company defendant, and which "suit was brought to restrain the infringement of the letters patent in "suit herein, the defendant in this cause, the David Bradley Manufactur- "ing Company, employed counsel, took charge of and conducted the "defense of said suit in the name of the said Bradley & Company and "paid the expenses thereof. This was done by the defendant herein, the "same as it would be done by it for any agent, branch house, or cus- "tomer engaged in selling implements purchased of the defendants, if "sued for infringement of a patent on account of selling such goods."

It also appeared in evidence that in the suit in the Circuit Court of the United States, for the Southern District of Iowa, against David Bradley & Co., the master, to whom the cause was referred to ascertain and report the complainant's damages, on or before October 15th, 1889, reported to the court as follows:

"That the complainant has already brought suit against the manu- "facturer of the cultivators which were sold by the defendant, electing to "recover in full of said manufacturer all profits and damages arising "from the sales by the defendant herein, as well as other profits and "damages, and for that reason will offer no proof of profits and dam- "ages in the cause. Accordingly the master reports that the complain- "ant is entitled to recover the sum of one cent nominal damages and "costs."

This report was made pursuant to the following stipulation of the parties:

"It is hereby mutually agreed by and between the Eagle Manu-
"facturing Company and the David Bradley Manufacturing Company,
"on this 25th day of September, 1889, as follows, to wit:

"That said Eagle Manufacturing Co. may cause the master in the
"case of *Eagle Manufacturing Co.* v. *David Bradley & Company*, pend-
"ing at Des Moines, Iowa, in the United States Circuit Court for the
"Southern District of Iowa, to return to the court the annexed report;
"and the action of the court thereon shall not be claimed by said David
"Bradley Manufacturing Co. to be a bar to the recovery by the Eagle
"Manufacturing Company of the said David Bradley Manufacturing
"Company of all damages and profits, if any, arising from the sale of the
"cultivators by the said David Bradley & Co. in violation of the letters
"patent 242,497, to E. A. Wright, and by him assigned to the Eagle
"Manufacturing Co."

On the 23rd day of October, 1889, the following written stipulation was signed and filed in the cause:

"The following proofs were offered in evidence in said cause this
"23d day of October, 1889:

"The complainant appeared by Nathaniel French, its solicitor, and
"the defendant, though not appearing, consented in writing to the intro-
"duction of said proofs, in so far as the same are material; and thereupon
"the complainant offered in evidence the final decree of the Circuit Court
"of the United States for the Southern District of Iowa, in the case of
"*Eagle Mfg. Co.* v. *David Bradley & Co.*, which same is marked 'Com-
"plainant's Exhibit Bradley Final Decree'; and thereupon the com-
"plainant offered in evidence a stipulation entered into by defendant in
"regard to the testimony of E. A. Wright, A. K. Raff, G. W. French
"and E. P. Lynch, taken in the case of *Eagle Mfg. Co.* v. *Miller*, pend-
"ing in the Circuit Court of the United States for the Southern District
"of Iowa, together with a copy of said depositions and the exhibits
"therein referred to.

"The complainant also offered in evidence the admission of the
"defendant that it conducted the defense in the said suit of *Eagle Mfg.*
"*Co.* v. *David Bradley & Co.;* and also a copy of letters patent No.
"226,833, to B. C. Bradley, dated April 27, 1880; and thereupon the
"complainant announced that its case was closed.

"The defendant herein hereby consents to the foregoing proceed-
"ings."

Under such stipulation the complainant offered and read in evidence the final decree of the Circuit Court of the United States for the Southern District of Iowa, in the case referred to, as follows:

"This case coming on for hearing on October 15, 1889, being the
"first day of the May term of said court, on the report of the master,

"and thereupon, in addition to the matters adjudged and decreed in the "decree hereinbefore rendered on May 23, 1888, it is now ordered, "adjudged and decreed that the report of the master be confirmed, and "that the complainant have and recover of the defendant the sum of "one cent nominal damages, and the costs of the reference to the master "to be taxed."

The answer in this cause asserts that the defendant, appellant here, is now constructing, selling, and using cultivators which are exactly the same as those sold by David Bradley and Co.; that such cultivators are manufactured under and in accordance with letters patent of the United States, No. 243,123, dated June 21, 1881, granted to Charles A. Hague, and No. 270,629, dated January 16, 1883, granted to Byron C. Bradley. It also asserts the invalidity of the appellee's patent for want of novelty, and that the invention was anticipated by certain letters patent specifically stated. These defenses were pleaded to the suit of this appellee against David Bradley & Co. See *Eagle Manufacturing Company* v. *Bradley*, 35 Fed. R., 295. The defenses here and there are substantially the same, except that here, in addition to the assertion of the patent to Dalton, common to the defenses in both suits, prior knowledge and use by Dalton is asserted independently of his patent. It is not claimed, however, that such use and knowledge goes further than the patent to him pleaded and considered by the court in the Iowa suit. There is this further exception that by an amendment to the answer here the appellant alleged prior use by "Charles A. Hague at Chicago, in the shops of the Furst & Bradley Manufacturing Company, now the David Bradley Manufacturing Company," in addition to the prior use asserted therefore in the answers both in the case here and in the suit in the Southern District of Iowa. The Hague patent was, however, asserted in the answer in the Iowa suit as one of the patents under which the appellant's cultivators were manufactured.

The court below entered an interlocutory decree for the complainant, containing the usual direction for an injunction, upon the ground that the decree in the Iowa case was binding upon the defendant, and precluded it from further contesting the validity of the complainant's patent. *Eagle Manufacturing Company* v. *Bradley Manufacturing Company*, 50 Fed. R., 193. The present appeal involves the correctness of that ruling.

JENKINS, *District Judge.*

The general rule that a judgment or decree of a court of competent jurisdiction between two parties is conclusive in any other suit between them, or their privies, of every matter that was decided therein, and that was essential to the decision made, is not here called in question. It is objected, however, that the rule ought not to govern here because, *First*, the decree in the suit in the Southern District of Iowa was, at the bring-

ing of this suit, interlocutory and not final and is not therefore *res adjudicata*. *Second*, the appellee has failed by supplemental bill, or otherwise, to plead the final decree in the former suit, and the record thereof was therefore improperly allowed in evidence. *Third*, that the appellee has by stipulation expressly waived its right to assert the former recovery, and *Fourth*, that a new defense not involved in the former case is here asserted.

I. The suit in the Circuit Court of the United States for the Southern District of Iowa, was brought to restrain the infringement of the same claims of the same patent here in question. The defendant there was the agent of the present appellant in the sale of the infringing machines. The defense of the suit there was assumed and prosecuted by the appellant here. The appellant was in fact the real party to that litigation, and, so far as the decree there is *res adjudicata*, is as effectively concluded thereby as if it were the actual defendant in the record.

Lovejoy v. *Murray*, 3 Wall., 1, 18,19.
Robbins v. *Chicago*, 4 Wall., 657,672.

That the decree was interlocutory at the bringing of this suit, and subsequently ripened into a final decree does not impair its efficacy or conclusiveness when properly presented in this suit. The relative time of institution of suit, or the relative date of final decree, is not of consequence if the merits of the controversy be thereby fully and finally determined and the record thereof is properly brought to the attention of this court.

Duffy v. *Lytle*, 5 Watts, 120.
Casabeer v. *Mowry*, 55 Pa. St. 422.
Child v. *Eureka Powder Works*, 45 N. H. 547.

II. It is doubtless necessary, where special pleading is required, that a former recovery should be pleaded in bar. There are cases where the record of a former recovery can be given in evidence without being specially pleaded. But this case is not one of them. We are therefore to enquire whether the allegations contained in the bill are sufficient to admit the record, and whether any objection to its admission was laid upon failure to properly plead the former recovery. For, if the record be properly before us in evidence, although not well pleaded, we are not at liberty to consider it, but are bound to give full effect to it.

The bill in apt terms pleads the former suit and the interlocutory decree rendered therein. Whether the pleader so charged it in the bill with the view to invoke the doctrine of comity, or as a supposed bar to an apprehended attack upon the validity of the patent, we cannot say. If the latter, it may be doubted whether it would not better accord with correct principles of equity pleading to assert a former recovery in bar by

replication or special plea. However that may be, the decree pleaded was not technically well pleaded as a bar, because, being interlocutory, while it affirmed the validity of the patent and the fact of infringement, it still remained in the breast of the Chancellor and was subject to change. But the appellant was advised by the bill that the interlocutory decree was relied upon by the appellee as a protection against further attack upon the patent in question, and no exception to the matter in the bill was taken. The object of all pleading is to fitly advise an opponent of the particular charges or defenses relied upon, that he may be prepared to meet the particular matter, and not be taken by surprise. Here the appellant—so far as respects the interlocutory decree—was not only fully apprized of the position of its opponent, but by its answer and stipulation conceded the facts charged and objected only to the decree that in rendering such judgment the court erred through failure to understand the operation of the Dalton machine, asserted to anticipate the invention of the appellee. While, therefore, the bill did not, in the view of strict pleading, present the issue of a former recovery because it did not allege, what did not at the time exist, the formal final decree; still when that final decree was offered in evidence, it was properly allowed and should be considered, unless proper objection was made to its reception upon the particular ground that it had not been pleaded. *Walsh* v. *Colclough*, 9 U. S. App., 56 Fed. R., 778. It was encumbent upon the appellant by fit objection at the time, or by subsequent motion to expunge, to have informed its opponent of the precise ground of objection. The objection could then have been obviated by amendment to the bill or by proper supplemental pleading. It is too late to urge such objection for the first time upon an appeal.

It is to be further observed that the record of the final decree was introduced in evidence upon the consent of the appellant. The language of the stipulation is, "The defendant, though not appearing, consented in writing to the introduction of said proofs in so far as the same are material." The stipulation covers four distinct matters allowed in evidence without other objection than that stated. The evident meaning of the stipulation is, that the matters offered should all be received in evidence, subject only to the question of their bearing upon the merits of the controversy. It was a waiver, in our opinion, of all formal objection. Materiality means "the property of substantial importance or influence especially as distinguished from formal requirement."—*Bouvier.* "Substantial as opposed to formal."—*Johnson.* It is clear to our minds that the only reservation made in the stipulation was the question of the influence of the evidence upon the controversy between the parties; whether the evidence tendered was of substance as affecting the matter in dispute. The stipulation ignores all formal requirements, all technical objections with respect to pleading. We conclude, therefore, that the final decree is properly in evidence, and should be considered and given in proper effect.

III. We are of opinion that the third objection, that the bar of a former recovery has been waived is not tenable.

All that remained to give full and final effect to the interlocutory decree of May 23, 1888, was the ascertainment of the damages and the formal entry of final decree. This bill was filed June 11, 1888. On the 25th September, 1889, the parties stipulated that in the suit in the Southern District of Iowa the master should report that the complainant (the appellee here) had brought suit against the manufacturer (the appellant here) of the infringing machines in controversy in that suit, "electing to recover in full of said manufacturer all profits and damages arising from the sales by the defendant herein, as well as other profits and damages, and for that reason will offer no proof of profits and damages in the cause," and that the master should report nominal damages against the defendant there; which was done. The stipulation further provided that the action of the court upon such report, "shall not be claimed by said David Bradley Manufacturing Co. to be a bar to the recovery by the Eagle Manufacturing Co. of the said David Bradley Manufacturing Co., of all damages and profits, if any, arising from the sale of the cultivator by the said David Bradley & Co., in violation of the letters patent 242,497, to E. A. Wright, and by him assigned to the Eagle Manufacturing Co." We cannot perceive that this stipulation has legal effect to waive the conclusiveness of the Iowa decree upon the validity of the patent and its infringement. The interlocutory decree had determined those questions; conclusively so when by final decree the matter was no longer at large. That would result, whatever the *quantum* of damages awarded. In the light of the situation of the parties at the time, the object and force of the stipulation is obvious. The validity of the patent, and its infringement, had been contested and determined against the agents of the appellant for the sale of its machines. The appellant had assumed the defense of that suit and was defeated. It was equally, with its agents, the defendant in that suit, liable for all damages sustained. If the nominal defendant had ignorantly infringed, being employed to do it, there was a certain equity that only nominal damages should be exacted, reserving to the appellee recourse to the more guilty infringer, the manufacturer. The appellant had, immediately upon the rendering of the interlocutory decree, instituted this suit to recover damages of the manufacturer for all damages sustained, whether by reason of the manufacture and sale of the machines in that suit adjudged to infringe, or of others. It was but just under such circumstances that substantial damages should be sought of the guilty manufacturer, rather than of a possibly innocent agent. Such proceeding was also in the way of economy in litigation. It was assumed that that course could be safely pursued, if by stipulation the manufacturer would waive the bar of a decree entered for nominal damages, and permit a recovery to be sought in this suit for the actual damages sustained by reason of the manufacture and sale of the infringing machines involved in that suit. The stipulation speaks that object and no other. It contains no intimation that the decree should be at large

with respect to the more important matter thereby put at rest—the validity of the patent. There is not any waiver of the bar of the decree in that respect. Nor does the record disclose to us any such purpose or intent. We cannot do violence to the plain language of the stipulation by importing into the agreement a stipulation not contained in it, nor authorized by the condition of the parties. It seems to us incredible that the appellee should release all the fruits of its victory without motive or apparent reason therefor. The stipulation in express terms limits the release of the bar of the decree to the subject of damages, and is a release by the appellant. In no way did the appellee waive any claim with respect to the effect of the decree.

Nor do we see in the fact that testimony was taken in this suit touching the validity of the patent, any reason to declare a waiver. Until final decree there was no *res adjudicata*. All such evidence was taken before the final decree of October 15, 1889, in the Iowa suit. Immediately thereafter, on the 23d day of October, 1889, the final decree was admitted in evidence here by consent of the appellant, together with the stipulation containing the admission of the appellant that it had assumed and conducted the defense of that suit; and the evidence was thereupon closed. We are not prepared to say that the taking of evidence upon the issue presented by a defendant is a waiver by the complainant of the bar of a former recovery, even when well pleaded. But if it be so, the rule cannot have application before such former recovery is rendered effectual by final decree. Nor do we perceive in the circumstances of the case any action of the appellee that tended to mislead the appellant to its prejudice. The latter consented to the admission in evidence of this final decree, coupled with its admission that it had assumed the defense of the Iowa suit. That record could have no other effect in evidence than as *res adjudicata*. It had no possible function to perform save as a bar to attack upon the validity of the patent. The appellant knew, or should have known, this. It knew, or should have known, that such was the purpose in its introduction. The right of appeal was perfect in the appellant, beyond the control of its opponent. It failed to assert its right. The appellee should not, therefore, lose the benefit of the decree. The consequences must fall where they justly belong, upon the one failing to take advantage of an absolute right.

IV. It is insisted that the matter is still at large with respect to certain defenses stated to have been not involved in the former case. This contention leads to the consideration of the question of the extent of the bar of the former recovery.

In *Cromwell* v. *County of Sac*, 94 U. S., 351, it was ruled that there existed a difference between the effect of a judgment as a bar or estoppel against the prosecution of a second action upon the same claim or demand, and its effect as an estoppel in another action between the same parties upon a different claim or cause of action. The distinction is thus stated by Mr. Justice Field:

"In the former case, the judgment, if rendered upon the merits, con-
"stitutes an absolute bar to a subsequent action. It is a finality as to the
"claim or demand in controversy, concluding parties and those in privity
"with them, not only as to every matter which was offered and received
"to sustain or defeat the claim or demand, but as to any other admis-
"sible matter which might have been offered for that purpose. Thus,
"for example, a judgment rendered upon a promissory note is conclusive
"as to the validity of the instrument and the amount due upon it, al-
"though it be subsequently alleged that perfect defenses actually existed,
"of which no proof was offered, such as forgery, want of consideration,
"or payment. If such defenses were not presented in the action, and
"established by competent evidence, the subsequent allegation of their
"existence is of no legal consequence. The judgment is as conclusive,
"so far as future proceedings at law are concerned, as though the de-
"fenses never existed. The language, therefore, which is so often used,
"that a judgment estops not only as to every ground of recovery or de-
"fense actually presented in the action, but also as to every ground which
"might have been presented, is strictly accurate, when applied to the de-
"mand or claim in controversy. Such demand or claim, having passed into
"judgment, cannot again be brought into litigation between the parties
"in proceedings at law upon any ground whatever.

"But where the second action between the same parties is upon a
"different claim or demand, the judgment in the prior action operates as
"an estoppel only as to those matters in issue or points controverted,
"upon the determination of which the finding or verdict was rendered.
"In all cases, therefore, where it is sought to apply the estoppel of a
"judgment rendered upon one cause of action to matters arising in a suit
"upon a different cause of action, the inquiry must always be as to the
"point or question actually litigated and determined in the original ac-
"tion, not what might have been thus litigated and determined. Only
"upon such matters is the judgment conclusive in another action."

In that case Cromwell brought action against the County of Sac upon four bonds of the county, and four coupons for interest attached to them. The county asserted a judgment in a prior action by one Smith upon certain earlier maturing coupons on the same bonds, and charged that Cromwell was at the time the owner of the coupons so sued upon, and prosecuted the action for his sole use and benefit. It was ruled in that action that the bonds were void, except in the hands of a *bona fide* holder for value, and failing proof of that fact judgment was rendered for the county. It was held that the judgment was conclusive only of the fact that the plaintiff could not recover the amount of the coupons sued for, and for the reason that he had not shown himself a *bona fide* holder for value, and that finding did not preclude Cromwell from showing, in another suit and as to bonds and coupons not there involved, that he was a *bona fide* holder thereof for value.

In *Davis* v. *Brown*, 94 U. S., 423, two of a series of notes had passed into judgment upon the sole defense by the endorsers that they had not been legally charged as such. In a second suit upon certain other notes of the series, the defense was asserted of an agreement by the plaintiff not to hold them liable for or to sue them upon their endorsements. The court held the former judgment not to be *res adjudicata* upon the new defense asserted to a different demand, saying by Mr. Justice Field (page 428):

"When a judgment is offered in evidence in a subsequent action "between the same parties upon a different demand, it operates as an "estoppel only upon the matter *actually at issue* and determined in the "original action; and such matter, when not disclosed by the pleadings, "must be shown by extrinsic evidence."

In *Campbell* v. *Rankin*, 99 U. S., 261, 263, the doctrine is thus stated by Mr. Justice Miller:

"Whatever may have been the opinion of other courts, it has been "the doctrine of this court in regard to suits on contract ever since the "case of the *Washington, Alexandria & Georgetown Steam Packet Com-* "*pany* v. *Sickles* (24 How. 333), and in regard to actions affecting real "estate since *Miles* v. *Caldwell* (2 Wall. 35), that whenever the same "question has been in issue and tried, and judgment rendered, it is con- "clusive of the issue so decided in any subsequent suit between the same "parties; and also, that where, from the nature of the pleadings, it would "be left in doubt on what precise issue the verdict or judgment was rend- "ered, it is competent to ascertain this by parol evidence on the second "trial. The latest expression of the doctrine is found in *Cromwell* v. "*County of Sac*, 94 U. S., 351; *Davis* v. *Brown*, id. 423."

In *Block* v. *Commissioners*, 99 U. S., 686, 693, Mr. Justice Strong asserts the doctrine as follows:

"Now, that a judgment in a suit between two parties is conclusive "in any other suit between them, or their privies, of every matter that "was decided therein, and that was essential to the decision made, is a "doctrine too familiar to need citation of authorities in its support. A "few cases go further, and rule that it is conclusive of matters incident- "ally cognizable, if they were in fact decided. To this we do not assent. "But it is certain that a judgment of a court of competent jurisdiction is "everywhere conclusive evidence of every fact upon which it must neces- "sarily have been founded."

In *Wilson's Executor* v. *Deen*, 121 U. S., 525,532, Mr. Justice Field re-states the principle thus:

"In *Cromwell* v. *County of Sac*, 94 U. S., 351, we considered at "much length the operation of a judgment as a bar against the prosec- "tion of a second action upon the same demand, and as an estoppel upon "the question litigated and determined in another action between the "same parties upon a different demand; and we held, following in this "respect a long series of decisions, that in the former case the judgment, "if rendered upon the merits, is an absolute bar to a subsequent action, "a finality to the demand in controversy, concluding parties and those in "privity with them; and, that in the latter case, that is, where the second "action between the same parties is upon a different demand, *the judg- "ment in the first action operates as an estoppel as to those matters in issue, "or points, controverted, upon the determination of which the finding or "verdict was rendered.*"

In *Bissell* v. *Spring Valley Township*, 124 U. S., 225, 231, Mr. Justice Field again re-states the doctrine as held by the court, in clear and unequivocal language, as follows:

"In *Cromwell* v. *County of Sac*, 94 U. S., 351, we drew a distinc- "tion between the effect of a judgment as a bar or estoppel against the "prosecution of a second action upon the same claim or demand, and its "effect as an estoppel in another action between the same parties upon a "different claim or demand. In the latter case, which is the one now "before us, we held, following numerous decisions to that effect, that the "judgment in the prior action operates as an estoppel only as to those "matters in issue, or points, controverted, upon the determination of "which the finding or verdict was rendered. The inquiry in such case, "therefore, we said, must always be as to the point or question *actually "litigated and determined* in the original action, for only upon such mat- "ters is the judgment conclusive in another action between the parties "upon a different demand. *Lumber Co.* v. *Buchtel*, 101 U. S., 638; "*Wilson's Executor* v. *Deen*, 121 U. S., 525."

The rule thus settled has been reiterated by the court in *Nesbit* v. *Riverside Independent District*, 144 U. S., 610, 618. *Wilmington & Weldon Railroad* v. *Alsbrook*, 146 U. S., 279, 302. *McComb* v. *Frink*, 149 U. S., 629, 641.

In the sense that the present suit is prosecuted for an infringement not involved in the prior adjudication, the demand is not the same. But that, we think, is not the proper criterion. The inquiry should be directed to the question whether the right asserted by the party as the foundation of this suit, is the same right determined by the previous action. For, if the former test should prevail as the standard, a patentee could never be precluded from asserting the validity of his patent against subsequent infringements by the one who had by previous judgment obtained adjudication against its validity. The former recovery in such case

would be conclusive only that the particular devices there involved did not infringe. The question of the validity of the patent would thus forever remain at large, without conclusive determination. We are of opinion, therefore, that this suit is upon the same claim and demand, to-wit: The patent that was involved and determined in the former suit. That this must be so appears clearly from an examination of the cases cited. Thus in *Wilson's Executor* v. *Deen*, *supra*, the lessor brought action for rental under a lease; the defense was that of fraud in procuring the lease and judgment passed for the defendant. In another action between the same parties for rental subsequently accruing under the same lease, the former recovery was pleaded in bar, against which it was urged that the demand was not identical, and *Cromwell* v. *County of Sac*, was invoked to sustain that position. The court, however, sustained the plea, saying of the former judgment that "it determined not merely for that case, but for all cases between the same parties, not only that there was nothing due for the rent claimed for the month of December, 1873, *but that the lease itself was procured by fraud and therefore void.*" The court cites with approval the case of *Gardner* v. *Buckbee*, 3 Cowen, 120, where two notes were given upon the sale of a vessel. In an action upon one of the notes the maker pleaded fraud in the sale, and a total failure of consideration, and judgment was rendered in his favor. In an action upon the other of the notes the record of the judgment in the former suit was offered in evidence in bar of the action. The Supreme Court held the judgment conclusive. Instances might be multiplied of like adjudications. We deem it only necessary to refer to, without enlarging upon, the following cases:

Lumber Co. v. *Buchtel*, 101 U. S., 638. *Life Insurance Co.* v. *Bangs*, 103 U. S., 780. *Elgin* v. *Marshall*, 106 U. S., 578, 579.

We are compelled, therefore, to the conviction that this suit falls within the first resolution in *Cromwell* v. *County of Sac*, namely, that it is the second action upon the same claim or demand, to-wit: Upon the claim for a monopoly granted by patent; and that the former decree, the question being necessarily involved and at issue in that cause, determines conclusively and for all time, as between the parties thereto and their privies, the validity of the patent. It can no more be made the subject of contention between them.

Nor do we apprehend the result could be different if the case could be held to fall within the second resolution of *Cromwell* v. *County of Sac.* If this suit can be construed upon a different claim or demand, because the alleged infringement was in the use of machines not involved in the former suit, still the prior decree would be conclusive upon the matters at issue essential to a recovery, and actually determined in such action. The validity of the patent was there at issue. Its invalidity was claimed, because, as there asserted, certain specified prior patents described the same invention, and because of prior use. The determination of the issue of invalidity was essential to any decree for the complainant in that

cause and was determined by the judgment. It is said here that the prior patent to Dalton, and prior use by Hague here asserted, was not then at issue. The Dalton patent was distinctly passed upon by the court, and was held unavailing to defeat the invention claimed. As to the alleged prior use by Hague, it may be said that it was in the prior suit alleged by the defendant with the sanction of the present appellant, that the cultivators complained of as infringing, were manufactured under the letters patent to Hague of June 21, 1881. This patent was some two weeks subsequent in date to the complainant's patent, and was held to infringe. Prior use by Hague may not have been specifically alleged, but the defendant there attacked the validity of the patent because of prior use and of anticipation by other patents.

It was a duty to have asserted all anticipating patents, and all prior use. The issue of the pleadings was novelty of invention. The testimony of prior use and of anticipatory patents bore upon the issue of novelty of invention. In a suit at law such issue is tendered by a plea of the general issue, and such evidence may be given thereunder upon giving a certain notice. So in a suit in equity, like defense of invalidity may be pleaded, "*and proofs of the same may be given upon like notice in the answer of the defendant and with the like effect.*" *R. S. Sec.* 4920. The statement so required of particular anticipating patents, and of prior use, is clearly a mere bill of particulars of evidence to establish the issue of want of novelty; not independent issues. So no new defense is here asserted. The matter charged is merely additional evidence in support of the issue presented and determined in the former suit. It was competent evidence in that suit without any statement of it in the pleading, if the objection of the statute was not timely urged. *Loom Company* v. *Higgins*, 105 U. S., 580. *Zanes* v. *Soffe*, 110 U. S., 200, 203.

The proposed evidence comes too late to be availing. The decree of a court is not the less conclusive because a party has failed to produce all the evidence at command, or because of newly discovered evidence. *Expedit reipublicae ut sit finis litium.*

The decree will be affirmed.

— IN THE —

UNITED STATES CIRCUIT COURT OF APPEALS,

FOR THE SEVENTH JUDICIAL CIRCUIT.

The David Bradley Manufacturing Company,
Appellant,
v.
The Eagle Manufacturing Company.

Moline Plow Company,
Appellant,
v.
The Eagle Manufacturing Company.

JENKINS' *Circuit Judge.*

The appellants present petitions for rehearing, principally upon the ground that we erred in holding that the former decree could be here considered. This proposition is predicated upon the ground that the former decree was not pleaded; and it is insisted that we have overlooked the rule that no decree can be made in favor of the complainant on grounds not stated in his bill.

The case of *Crockett* v. *Lee*, 7 Wheaton, 522, is supposed by counsel to be decisive against our decision. There, the case below turned principally on the question whether a certain location was too vague to be supported. And it was insisted upon appeal that the decree was erroneous, because the court should have disregarded the testimony in that respect, for the reason that neither its vagueness nor its certainty had been put in issue by the pleadings; and the court so held. But that court, recognizing the injustice of permitting parties to try and submit their cause in the court below upon an issue not raised by the pleadings, and to enter that objection for the first time upon appeal, while feeling bound to assert the rule, was very careful to find a ground upon which to reverse the cause, with direction to permit the parties to amend their pleadings. This case was decided in 1822. It is within the knowledge of the profession that at that time, both in law and in equity, great stress was laid upon strict adherence to the issues presented by the pleadings, and to a technical conformity of proof to allegation. It was carried to the extreme of

injustice. Since that time there has been evolution in the science of the law in respect of that subject. Parties are no longer turned out of court because their *i's* are not dotted, or their *t's* crossed; and courts are diligent rather to search for the substantial justice of a case, than to insist upon strict conformity to pleading. And, while the rule remains, courts at the present day are not inclined to permit parties, for the first time upon appeal, to assert the objection that the testimony, which has been taken without objection in the court below, supports an issue not comprehended within the allegations of the pleading.

The Supreme Court of the United States has asserted this principle in the late case of the *Wasatch Mining Company* v. *Crescent Mining Company*, 148 U. S., 293, 298, 300, where a similar objection is disposed of upon the ground that the defendant did not object to the plaintiff's evidence as exhibiting a different case from that asserted in the bill, and that the Supreme Court of the Territory from which the cause came justly held that the objection should have been raised in the trial court, where ample power existed to correct and amend pleadings; and not having done so, but having gone to trial on the merits, the defendant was precluded from assigning error for matter so waived. The doctrine of waiver is thus invoked to mitigate the hardship of the rule if it should be applied to cases where parties without objection have made the issue by their evidence.

The issue here was novelty of invention. The prior interlocutory decree was pleaded, either as a bar, or as matter more or less conclusive upon the question of novelty, or perhaps in invocation of the doctrine of comity. It is immaterial which. If as a bar the pleading was defective upon the technical ground that the interlocutory decree had not ripened into a final decree, because the damages had not then been assessed. The validity of the patent had been determined, subject only to the power of the court to change its judgment before final decree. No objection was made to the sufficiency of the pleading when the final decree was stipulated in evidence. We are well satisfied that thereby the appellant waived the defective nature of the pleading, if the pleading is to be treated as a plea of *res adjudicata*.

Irrespective, however, of any question of pleading, we are of opinion that the former decree was properly before the court, and should be given full effect. The issue involved in this case was novelty of the invention claimed. The former decree was, as has been said, stipulated in evidence by the agreement of the parties, subject only to its materiality. A former decree may be good as a plea in bar, or may be available as evidence. It was said in the *Duchess of Kingston's* case, II *State Trials*, 261, 2 Smith Lead Cas., 6th Am. Ed., 663, that such decree is "as a plea, a bar, or as evidence, conclusive." It may, perhaps, be somewhat questionable whether it is correct to say that a party is estopped by a judgment any more than that he is estopped by a contract. The former decree is not the act of the party, but the solemn adjudication of a judicial tribunal. So far as the party is concerned, he may be permitted to waive the former

recovery in his own behalf; but the peace and good order of society are likewise concerned that there shall be an end to litigation, and that the courts should not be twice vexed with the same controversy, when that controversy has once been solemnly adjudicated. *Marsh* v. *Pier*, 4 Rawle, 288 ; *Kilheiffer* v. *Kerr*, 7 Sarg. & Rawle, 319.

However that may be, it is certainly true that, without respect to pleading, wherever a former recovery is properly in evidence—as here it was by agreement of the parties—full effect should be given to it, so far as it bears upon the issue presented. The issue here being novelty of invention, and that fact having been determined by the prior adjudication, the former decree becomes conclusive evidence of the validity of the patent, as between the parties effected by such prior adjudication.

The petition for rehearing will be overruled.

MONDAY, June 12, 1892.

Present: Honorable JOHN M. HARLAN,
Circuit Justice.
Honorable WALTER Q. GRESHAM,
Circuit Judge.
Honorable WILLIAM A. WOODS,
Circuit Judge.

22. David Bradley Manufacturing Company,
v.
The Eagle Manufacturing Company,

It is ordered by the court that the hearing of this cause be, and it is hereby, continued until next term.

SATURDAY, October 1, 1892.

Present: Honorable WALTER Q. GRESHAM,
Circuit Judge.
Honorable WILLIAM A. WOODS,
Circuit Judge.
Honorable JAMES G. JENKINS,
District Judge.

22. David Bradley Manufacturing Company,
v.
The Eagle Manufacturing Company.

It is ordered by the court that this cause be, and is hereby, set down for hearing for the 6th day of October, 1892.

THURSDAY, October 6, 1892.

Present: Honorable WALTER Q. GRESHAM,
Circuit Judge.
Honorable WILLIAM A. WOODS,
Circuit Judge.
Honorable JAMES G. JENKINS,
District Judge.

22. David Bradley Manufacturing Company,
v.
The Eagle Manufacturing Company.

Now this day came the parties by their counsel and this cause having been partly heard upon the printed record and briefs of counsel and upon oral argument of counsel the further hearing thereof is postponed until to-morrow morning.

FRIDAY, October 7, 1892.

Present: Honorable WALTER Q. GRESHAM,
Circuit Judge.
Honorable WILLIAM A. WOODS,
Circuit Judge.
Honorable JAMES G. JENKINS,
District Judge.

22. David Bradley Manufacturing Company,
v.
The Eagle Manufacturing Company.

Now, again, came the parties by their counsel this day and this cause having been heard to conclusion upon the printed record and briefs of counsel and upon oral arguments of counsel the court takes this matter under advisement.

FRIDAY, October 6, 1893.

Present: Honorable WILLIAM A. WOODS,
Circuit Judge.
Honorable JAMES G. JENKINS,
Circuit Judge.

22. David Bradley Manufacturing Company,
v.
The Eagle Manufacturing Company.

Appeal from the Circuit Court of the United States for the Northern District of Illinois.

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Northern District of Illinois and was argued by counsel. On consideration whereof it is now here ordered, adjudged, and decreed by this court that the decree of the said Circuit Court in this cause be, and the same is hereby, affirmed with costs.

FRIDAY, December 8, 1893.

Present: Honorable WILLIAM A. WOODS,
Circuit Judge.
Honorable JAMES G. JENKINS,
Circuit Judge.

22. David Bradley Manufacturing Company,
v.
The Eagle Manufacturing Company.

It is ordered by the court that the petition for re-hearing in this cause be, and the same is hereby, overruled.

UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

I, Oliver T. Morton, clerk of the United States Circuit Court of Appeals for the Seventh Circuit, do hereby certify that the foregoing pages contain a true copy of the transcript of the record as brought to this court by an appeal and the proceedings in this court in the case of David Bradley Manufacturing Company *v.* The Eagle Manufacturing Company, No. 22, October Term, 1891, as the same remains upon the files and records of said United States Circuit Court of Appeals for the Seventh Circuit.

In testimony whereof I hereunto subscribe my name and affix the seal of said United States Circuit Court of Appeals for the Seventh Circuit at the city of Chicago this 11th day of January, A. D. 1894.

[SEAL.] OLIVER T. MORTON,
Clerk of the United States Circuit Court of Appeals for the Seventh Circuit.

MONDAY, December 7, 1891.

The folllowing order is entered by direction of

Honorable HENRY BLODGETT,
District Judge.

The Eagle Manufacturing Company,
vs.
The Moline Plow Company.

Appeal from the Circuit Court of the United States in and for the Northern District of Illinois.

Upon motion of the complainant it is hereby ordered that the time for the complainant to file its record in the above-entitled cause is hereby extended twenty days from this date.

MONDAY, June 12, 1892.

Present: Honorable JOHN M. HARLAN,
Circuit Justice.
Honorable WALTER Q. GRESHAM,
Circuit Judge.
Honorable WILLIAM A. WOODS,
Circuit Judge.

26. The Moline Plow Company,
vs.
The Eagle Manufacturing Company.

It is ordered by the court that the hearing of this cause be, and it is hereby, continued until the next term.

SATURDAY, October 1, 1892.

Present: Honorable WALTER Q. GRESHAM,
Circuit Judge.
Honorable WILLIAM A. WOODS,
Circuit Judge.
Honorable JAMES G. JENKINS,
District Judge.

26. The Moline Plow Company,
vs.
The Eagle Manufacturing Company.

It is ordered by the court that this cause be, and is hereby, set down for hearing for the 6th day of October, 1892.

THURSDAY, October 6, 1892.

Present: Honorable WALTER Q. GRESHAM,
Circuit Judge.
Honorable WILLIAM A. WOODS,
Circuit Judge.
Honorable JAMES G. JENKINS,
District Judge.

26. The Moline Plow Company,
vs.
The Eagle Manufacturing Company.

Now this day came the parties by their counsels and this cause having been partly heard upon the printed record and briefs of counsel and upon oral argument of counsel the further hearing thereof is postponed until to-morrow morning.

FRIDAY, October 7, 1892.

Present: Honorable WALTER Q. GRESHAM,
Circuit Judge.
Honorable WILLIAM A. WOODS,
Circuit Judge.
Honorable JAMES G. JENKINS,
District Judge.

26. The Moline Plow Company,
vs.
The Eagle Manufacturing Company.

Now, again, came the parties by their counsel this day and this cause having been heard to conclusion upon the printed record and briefs of counsel and upon oral arguments of counsel the court takes this matter under advisement.

FRIDAY, October 6, 1893.

Present: Honorable WILLIAM A. WOODS,
Circuit Judge.
Honorable JAMES G. JENKINS,
Circuit Judge.

26. The Moline Plow Company,
vs.
The Eagle Manufacturing Company.

An appeal from the Circuit Court of the United States for the Northern District of Illinois.

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Northern District of Illinois and was argued by counsel. On consideration whereof it is now here ordered, adjudged, and decreed by this court that the decree of the said Circuit Court in this cause be, and the same is hereby, affirmed with costs.

FRIDAY, December 8, 1893.

Present: Honorable WILLIAM A. WOODS,
Circuit Judge.
Honorable JAMES G. JENKINS,
Circuit Judge.

26. Moline Plow Company,
vs.
Eagle Manufacturing Company.

It is ordered by the court that the "petition for re-hearing" in this cause be, and the same is hereby, overruled.

UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

No. 26.—OCTOBER SESSION, 1892.

The Moline Plow Company,
Appellant,
vs.
The Eagle Manufacturing Company,
Appellee.

On appeal from the Circuit Court of the United States for the Northern District of Illinois.

Before GRESHAM and WOODS, Circuit Judges, and JENKINS, District Judge.

JENKINS, *District Judge.*

This case differs in no essential particulars from that of *David Bradley Manufacturing Company*, appellant, *vs. The Eagle Manufacturing Company*, herewith decided. It presents the same questions and is controlled by the same rules of law. The decree is, therefore,

Affirmed.

Filed October 6, 1893.

UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

I, Oliver T. Morton, clerk of the United States Circuit Court of Appeals for the Seventh Circuit, do hereby certify that the foregoing pages contain a true copy of the transcript of the record as brought to this court by an appeal and the proceedings in this court in the case of The Moline Plow Company *vs.* The Eagle Manufacturing Company, No. 26, October Term, 1891, as the same remains upon the files and records of said United States Circuit Court of Appeals for the Seventh Circuit.

In testimony whereof I hereunto subscribe my name and affix the seal of said United States Circuit Court of Appeals for the Seventh Circuit at the city of Chicago this 11th day of January, A. D. 1894.

OLIVER T. MORTON,
Clerk of the United States Circuit Court of Appeals for the Seventh Circuit.

Supreme Court of the United States.

OCTOBER TERM, A. D. 1893.

IN THE MATTER OF THE APPLICATION OF THE DAVID BRADLEY MANUFACTURING COMPANY AND THE MOLINE PLOW COMPANY FOR WRITS OF CERTIORARI UNDER SECTION 6 OF THE ACT OF CONGRESS APPROVED MARCH 3D, 1891, CREATING THE CIRCUIT COURTS OF APPEALS.

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Come the said petitioners, the David Bradley Manufacturing Company and the Moline Plow Company, and respectfully petition this Honorable Court to grant writs of *certiorari* directed to the United States Circuit Court of Appeals for the Seventh Judicial Circuit, under the provisions of § 6 of the Act of Congress approved March March 3d, A. D. 1891, creating the Circuit Courts of Appeals, and ordering that the records in the cases of the *David Bradley Manufacturing Company, Appellant*, v. *The Eagle Manufacturing Company, Appellee*, and the *Moline Plow Company, Appellant*, v. *The Eagle Manufacturing Company, Appellee*, Nos. 22 and 26, respectively, be certified to this Honorable Court, where the decision of said Circuit Court of Appeals in the said cases may be reviewed by this Honorable Court.

The two cases above referred to were tried in the Cir-

cuit Court, and, on appeal, in the Circuit Court of Appeals, practically as one case, and the records in both cases were substantially the same. The suits are based upon U. S. patent No. 242,497, recently held invalid by this court in *Miller* v. *Eagle Mfg. Co.* Upon these records (of which a certified copy is furnished and filed with this petition) only one question arises, only one point is involved upon which we ask the decision of this Honorable Court, and upon which this petition for writs of *certiorari* is based. That question is a proposition of law, and in order to bring that proposition of law fairly before the court at the first instance, we will state it here. It is this:

Under the practice of the Courts of King's Bench and of Chancery in England, which is the basis of the equity practice of the United States courts, can a decree be based and relief granted upon evidence concerning which no allegation is made and for which no foundation is laid in the bill?

The records in these cases are long, but the greater part of them has nothing to do with the point in controversy, upon which this petition for *certiorari* is based. The facts which appear from these records, and upon which the question above stated arises, may be stated very briefly. As was stated above, the two cases were tried as one upon the same state of facts, so far as the point in question is concerned. We will, therefore, briefly state the facts involving this point in the David Bradley Manufacturing Company case, it being understood that exactly the same facts are applicable to the Moline Plow Company case, the names only being changed. Those facts are as follows:

Some time prior to the year 1888, a bill was filed by the Eagle Manufacturing Company against David Brad-

ley & Co. in the United States Circuit Court for the Southern District of Iowa. David Bradley & Co., the defendants in that suit, were the agents of the David Bradley Manufacturing Company, one of the petitioners in this petition, and that suit was, in fact, defended by the David Bradley Manufacturing Company. Evidence was taken upon the merits by both parties in that case, and on the 23d day of May, 1888, there was entered in the United States Circuit Court for the Southern District of Iowa a decree which, for brevity, we will refer to as the "Bradley Interlocutory Decree." (Record, p. 13 and p. 198.) This was an interlocutory decree of the usual form, finding the complainant's patent sued on valid, and finding that the defendants had infringed, granting an injunction, and referring the cause to a Master in Chancery to take proofs upon the question of profits and damages.

Upon the 11th day of June, 1888, the bill in the case at bar was filed by the Eagle Manufacturing Company against the David Bradley Manufacturing Company in the Circuit Court of the United States for the Northern District of Illinois. In that bill, after the usual recitals, the following allegations were made:

"And your orator further shows that it commenced "suit by bill in chancery in the Circuit Court of the "United States for the Southern District of Iowa, East-"ern Division, against the Davenport Plow Company, "to restrain the said Davenport Plow Company "from making and selling cultivators infringing "upon the exclusive rights of the complainant under "said letters patent, and that the said Davenport Plow "Company filed its answer denying the validity of said "letters patent and any infringement thereof, to which an-"swer a replication was duly filed by the complainant; "and thereupon the parties, complainant and defendant,

"proceeded to take their respective proofs, and the same "having been taken, the cause was heard by the said "court on final hearing, and the court having considered "the proofs and the arguments of counsel pro and con, "did adjudge and decree that the said letters patent were "valid, that the defendant had infringed the same, and "did enjoin and restrain the defendant from future in- "fringement thereof, which said decree still remains in "full force and unreversed, all of which facts will more "fully appear by the records of said court, which, or a "certified copy thereof, your orator is ready in court to "procure at any time, as may by the court be directed, "and your orator attaches hereto a certified copy of said "decree, marked 'Exhibit B.'

"And your orator further shows that on the . . . "day of December, 1887, shortly after the rendition of "said decree against the said Davenport Plow Company, "it commenced suit, by bill in chancery, against David "Bradley & Co. in the Circuit Court of the United "States for the Southern District of Iowa, to restrain the "said David Bradley & Co. from infringing the afore- "said letters patent. That the said David Bradley & Co. "is and was a branch house of the David Bradley Manu- "facturing Company, the defendant herein, and was en- "gaged in selling the identical cultivators manufactured "by the defendant herein; that the defendant herein un- "dertook and managed the defense of said suit against its "branch house, employing counsel for that purpose and "conducting the defense, but it conducted the defense in "the name of the said branch house, the defendant named "of record. That the defendant herein, answering said bill "in the name of the said branch house, denied the valid- "ity of said letters patent and any infringement thereof, "to which answer a replication was filed by your orator,

"and, thereupon, your orator and the defendant pro-
"ceeded to take, and took, their respective proofs, and the
"same having been taken, the said cause was heard on
"final hearing at the May term of said court, at Des
"Moines, A. D. 1888. And the said court, having con-
"sidered the proofs and the arguments of counsel, did
"adjudge and decree that the said David Bradley & Co.
"had infringed the aforesaid letters patent, and did en-
"join the aforesaid David Bradley & Co. from further
"infringement thereof, which said decree remains in full
"force and unreversed; all of which proceedings and things
"will appear more fully by a certified copy of the records
"of said court, which your orator is ready at any time to
"produce in court as may be directed; and your orator
"attaches hereto a certified copy of said decree, marked
"'Exhibit C.'" (Record, pp. 4–5.)

To this bill an answer in the usual form was filed by the defendant. (Record, p. 17.) The replication of the complainant was filed to said answer, and an amendment to the answer filed, by consent, by defendant. (Record, p. 25.) Thereupon proofs were put in by both parties upon the merits, between November 10th, 1888, and October, 1889.

Upon September 25th, 1889, the following agreement was made in the Iowa case:

"It is hereby mutually agreed by and between the
"Eagle Manufacturing Co. and the David Bradley Manu-
"facturing Co., on this 25th day of September, 1889, as
"follows, to-wit:

"The said Eagle Manufacturing Co. may cause the
"Master in the case of *Eagle Manufacturing Co.* v. *David*
"*Bradley & Company*, pending at Des Moines, Iowa,
"in the United States Circuit Court for the Southern Dis-

"trict of Iowa, to return to the court the annexed report, "and the said report and the action of the court thereon "shall not be or be claimed by the said David Bradley "Manufacturing Co. to be a bar to the recovery by the "Eagle Manufacturing Co. of the said David Bradley "Manufacturing Co. of all damages and profits, if any, "arising from the sale of the cultivators by the said David "Bradley & Co., in violation of letters patent 242,497, to "E. A. Wright, and by him assigned to the Eagle Man- "facturing Co.

"DAVID BRADLEY MANUFACTURING CO.,
"*By West & Bond, Solicitors.*
"EAGLE MANUFACTURING CO.,
"*By Matt. French, Solicitor.*"

(Record, p. 27.)

On February 3rd, 1889, a Master's Report was entered in the Iowa case, finding nominal damages, in pursuance of said agreement. On October 15th, 1889, a final decree was entered in said Circuit Court of the Southern District of Iowa, in the usual form; for the sake of brevity we shall refer to this as the "Bradley Final Decree." On October 23rd, 1889, the following proofs were offered in evidence in the case at bar, then pending in the Circuit Court of the United States for the Northern District of Illinois:

"The complainant appeared by Nathaniel French, its "solicitor, and the defendant, though not appearing, "consented in writing to the introduction of said proofs, "in so far as the same are material; and thereupon the "complainant offered in evidence the final decree of the "Circuit Court of the United States for the South- "ern District of Iowa, in the case of *Eagle Mfg. Co.* "v. *David Bradley & Co.*, which same is marked

"'Complainant's Exhibit Bradley Final Decree;' "and thereupon the complainant offered in evidence a "stipulation entered into by defendant in regard to the "testimony of E. A. Wright, A. K. Raff, G. W. "French and E. P. Lynch, taken in the case of *Eagle* "*Mfg. Co.* v. *Miller*, pending in the Circuit Court of "the United States for the Southern Distaict of Iowa, "together with a copy of said depositions and the "exhibits therein referred to.

"The complainant also offered in evidence the admis- "sion of the defendant that it conducted the defense in "the said suit of *Eagle Mfg. Co.* v. *David Bradley &* "*Co.*, and also a copy of letters patent No. 226,833, to "B. C. Bradley, dated April 27, 1880; and thereupon "the complainant announced that its case was closed.

"The defendant herein hereby consents to the foregoing proceedings.

"WEST & BOND,
"*For Defendants.*"

(Record, p. 66.)

Complainant in the case at bar made no attempt, by motion for leave to amend its bill, by application for leave to file a supplemental bill or otherwise, to set up the Bradley final decree, or make it an issue in the case, *but let its bill stand exactly as originally filed.* Upon the hearing of the case at bar, the Circuit Court found that the defendant, the David Bradley Manufacturing Company, was estopped, by reason of the Bradley final decree, from entering upon or in any way inquiring into the merits of the controversy; that the question of the validity of the patent and of infringement by the defendant was, by reason of that final decree, *res adjudicata*, and entered a decree accordingly. Upon appeal, this decision was affirmed by the Circuit Court of Appeals.

From the facts, as above stated, it appears that the Bradley final decree was not *alleged in the bill of complaint, and was not in any way brought into the case by amendment to that bill, by supplemental bill or otherwise.* It is obvious, then, that when the Circuit Court of the Northern District of Illinois found that the defendants were estopped from putting in any proofs upon the merits of the controversy by reason of the Bradley final decree, it based its decision upon facts which were not alleged in the bill in any way whatever, and granted a relief which had no foundation in the allegations of the bill or in the prayer for relief. Whether or not, upon these facts, the Circuit Court of the Northern District of Illinois, under the general rules of chancery practice, had a right to enter that decree of estoppel and grant relief based wholly on the question of *res adjudicata*, is the only question which we ask this court to consider.

We maintain that the law laid down by a long line of authorities, without exception or deviation, is as follows:

1. That the practice of the Courts of King's Bench and Chancery in England is the basis of the chancery practice in the United States courts, except as modified by the rules of this court.

2. That neither under said rules nor said practice can relief be granted except upon and according to the allegations of the bill, regardless of what the proof may be, and regardless of the question whether or not more than a general objection, or even whether or not any objection at all was taken to the evidence upon which the decree is based.

In support of these propositions of law, we cite in our brief, filed herewith, a long line of authorities, some of which, with other authorities supposed to make against these, we as briefly as possible consider.

The point upon which we ask the consideration of this court, and upon which this petition for writs of *certiorari* is based, is a point the settling of which in one way or the other by this Honorable Court we believe to be of great importance not only to the cases in question, but to general practice throughout the entire country. The question involved is a question of chancery practice, which we believe, and which we have tried to make clear in our brief filed herewith, has been decided by this court in one way and by the Circuit Court of Appeals in a precisely contrary way. If the decision of this Honorable Court is to be overruled, we believe that it should be done by this court and not by the Circuit Court of Appeals.

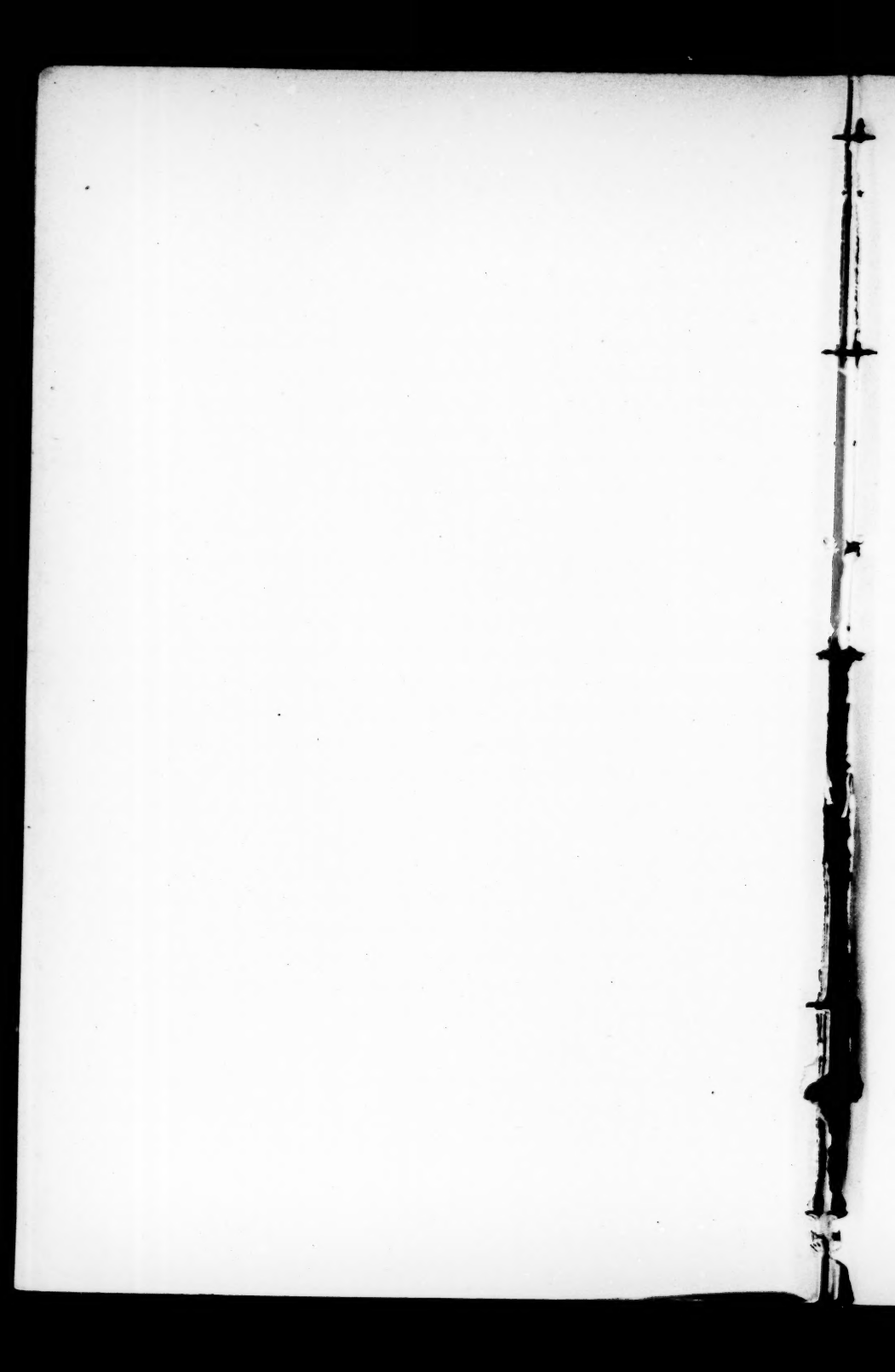
It will not be necessary for this court, in considering this point, to go into the large record in these cases in detail. The facts are clear from an inspection of the few pages of the record which we have above referred to, and from an inspection of the first part of the opinion of the Circuit Court of Appeals, a copy whereof is filed with this petition.

In order that this question, involving a point of chancery practice of great importance, as we believe, may be conclusively settled, we respectfully ask this court that writs of *certiorari* may be granted in thase cases, to this court, where the single point involved may be argued fully and decided by this Honorable Court.

And your petitioners will ever pray, etc.

DAVID BRADLEY MANUFACTURING CO.,
MOLINE PLOW CO.,
By L. L. BOND and C. E. PICKARD,
Their Attorneys.

L. L. BOND,
C. E. PICKARD,
Of Counsel.



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Supreme Court of the United States.

OCTOBER TERM, A. D. 1893.

IN THE MATTER OF THE APPLICATION OF THE DAVID BRADLEY MANUFACTURING COMPANY AND THE MOLINE PLOW COMPANY FOR WRITS OF CERTIORARI UNDER SECTION 6 OF THE ACT OF CONGRESS APPROVED MARCH 3D, 1891, CREATING THE CIRCUIT COURTS OF APPEALS.

BRIEF IN SUPPORT OF PETITION FOR WRITS OF CERTIORARI, TO DECIDE A QUESTION OF CHANCERY PRACTICE.

L. L. BOND,
C. E. PICKARD,
Counsel for Petitioners.

EASTMAN BROS., LAW PRINTERS, 187 WASHINGTON ST., CHICAGO.

Supreme Court of the United States.

OCTOBER TERM, A. D. 1893.

IN THE MATTER OF THE APPLICATION OF THE DAVID BRADLEY MANUFACTURING COMPANY AND THE MOLINE PLOW COMPANY FOR WRITS OF CERTIORARI UNDER SECTION 6 OF THE ACT OF CONGRESS APPROVED MARCH 3D, 1891, CREATING THE CIRCUIT COURTS OF APPEALS.

BRIEF IN SUPPORT OF PETITION FOR CERTIORARI.

May it please the Court:

These suits are based upon U. S. patent No. 242,497, recently held invalid by the court in the case of *Miller* v. *Eagle Mfg. Co.*

As is stated in our petition filed herewith, there is involved in the record of this case only one point, and that is a proposition of law looking only to a question of general chancery practice in the Federal courts. The ruling of the Circuit Court of Appeals upon this question, overruling, we confidently assert, several decisions of this court, is the only ground upon which this petition is based.

We insist that it is firmly and finally established, by a long line of cases, that under the equity rules and under the practice of the Courts of King's Bench and Chancery, which is the basis of the equity practice of the Federal courts, no decree can be based, and no relief

granted, except upon and according to the allegations of the bill, regardless of what the proof may be, and regardless of the question whether or not any objection at all was taken to the evidence upon which that decree is based.

Story Eq. Pl., § 257.
Crockett v. *Lee*, 7 Wheat., 522.
English v. *Foxhall*, 2 Pet., 595 (612).
Vattier v. *Hinde*, 7 Pet., 252 (273).
Harrison v. *Nixon*, 9 Pet., 483.
Boone v. *Chiles*, 10 Pet., 177 (208).
Jackson v. *Ashton*, 11 Pet., 229.
Patten v. *Taylor*, 7 How., 132.
Harding v. *Handy*, 11 Wheat., 103 (119–120).
Rubber Co. v. *Goodyear*, 9 Wall., p. 793.
James v. *McKernon*, 6 John., 543.
Woodcock v. *Bennett*, 1 Cowan, p. 734.
Thomas v. *Austin*, 7 Barb., p. 273.
Ferguson v. *Ferguson*, 2 N. Y., 361.
Langdon v. *Roane*, 6 Ala., 518.
Maury v. *Mason*, 8 Port. (Ala.), 211.
Bozman v. *Draughan*, 3 Stewart (Ala.), 243 (246).
Cloud v. *Whiteman*, 2 Harr. (Del.), 401.
Lipp v. *Horbach*, 12 Neb., 371.
Smith v. *Smith*, 1 Ired. (N. C.), 83 (85).
Pigg v. *Corder*, 12 Leigh. (Va.), 69 (78–80).
Gregory v. *Power*, 3 Litt. (Ky.), 339.
Clarke v. *Turton*, 11 Ves. Jr., 240.
Morrison v. *Hart*, 2 Bibb., 4 (7).
Lemaster v. *Buckhart*, 2 Bibb., 25.
Lingan v. *Henderson*, 1 Bland, 236.
Hall v. *Maltby*, 6 Price, 240 (259).
McKay v. *Bissett*, 5 Gil. (Ill.), 499.
White v. *Morrison*, 11 Ill., 361 (366).

Root v. *Renwick*, 15 Ill., 461 (463).
Rowan v. *Bowels*, 21 Ill., pp. 17–19.
Mumm v. *Burges*, 70 Ill., 604 (611–12).
Morris v. *Tillson*, 81 Ill., 607 (615).
And cases cited in above.

As we have pointed out in our petition, the facts upon which the above propositions are based, are found in a very few of the pages of the record, and it will be necessary for this court to examine the record only to that extent. These facts also clearly appear in the statement of the case, preceding the opinion of the Circuit Court of Appeals, a copy of which is filed with the record.

On appeal from the decision of the Circuit Court to the Circuit Court of Appeals, it was urged:

(1.) That the Bradley interlocutory decree was not an estoppel, because such a decree was not a final decree, upon which alone such an estoppel can be based.

Bigelow on Estoppel, Chap. 11, § 11, paragraph 4, and cases cited.
Linington v. *Strong*, 111 Ill., 154 (159).
Harmon v *Struthers*, 48 Fed. Rep., 260.

(2.) That the appellee had an opportunity to plead the Bradley final decree, if not by amendment, by the filing of a supplemental bill.

Story Eq. Pl., § 332–336 *et seq.*
Daniels Chy. Pr., Vol. 2, pp. 1494 *et seq.*
Rules of Practice in Equity, Rules 55, 56, 57.

(3.) That to take advantage of estoppel by record (*res adjudicata*), the facts constituting such an estoppel must be pleaded, when there is opportunity to do so; otherwise such estoppel is waived, and evidence of such

judgment is either inadmissible in evidence, or, if admissible under the pleadings, not conclusive.

Voogt v. *Winch*, 2 Barn. & Ald., 662.
Howard v. *Mitchell*, 14 Mass., 242.
Eastman v. *Cooper*, 15 Mass., 276.
Gilbert v. *Thompson*, 9 Cush., 348.
Sprague v. *Waite*, 19 Pick., 455.
Meiss v. *Gill*, 44 Ohio St., 253, 258.
Picquet v. *McKay*, 2 Blackf., 465.
Fanning v. *Ins. Co.*, 37 Ohio St., 344, 346.
Crawford v. *Nolan*, 70 Ia., 97.
Ind. Dist. of Burlington v. *Merchants' Natl. Bank*, 68 Ia., 343.
Gill v. *Rice*, 13 Wis., 549.
Isaacs v. *Clark*, 12 Vt., 692.
Adams v. *Barnes*, 17 Mass., 368.
Bigelow on Estoppel, Chap. 22.
Wells on Res Adjudicata, Sec. 404 *et seq.*
Notes on Duchess of Kingston's Case.
Smith's Leading Cases, Vol. 2, Am. Ed.

In its opinion, the Circuit Court of Appeals held:

1. That the interlocutory decree of the Iowa court did not make the subject-matter of the suit *res adjudicata* and could not work an estoppel.

2. That only the final decree of that court made the subject-matter *res adjudicata*.

3. That such final decree could not, properly, be put in evidence if not pleaded.

4. That such final decree was not pleaded as a bar.

That court, however, held that such final decree, though not pleaded, was properly considered and properly given full effect as an estoppel; first, because of the stipulation under which it was admitted, and, second, because not

objected to by appellant upon the specific ground that it was not pleaded.

Thereupon appellants filed a petition for a rehearing in the Circuit Court of Appeals, taking the broad ground stated in the proposition first laid down herein, and also that the stipulation consented to the putting in evidence only of "material" matters, and, therefore, was by its own terms a valid objection to the admission of such final decree upon the ground of immateriality. The rehearing was, however, denied, upon grounds laid down in the opinion of the Circuit Court of Appeals, a copy of which is filed herewith, the chief ground being that the case of *Crockett* v. *Lee*, 7 Wheat., 522, was "decided in 1822, " since which this court has decided the case of *Wasatch Mfg. Co.* v. *Crescent Mfg. Co.*, 148 U. S., 30. But we confidently assert, as we asserted below, that under the rules of chancery practice:

First. The stipulation and circumstances under which that final decree was offered in evidence constitute either a general objection to the introduction of that final decree, or an objection on the ground of immateriality.

Second. That it was wholly unnecessary to object to the introduction of the final decree upon the special ground that it was not pleaded.

Third. That it was unnecessary for appellant to object at all, and that the court had no right to consider the final decree and to base a decree upon it, whether objected to or not.

In support of the first point, we call the attention of the court to the fact that no notice was given to appellant of the proceedings under which this final decree, with other matters, was put in evidence. Petitioner was, therefore, not in default, and such proceedings were valid only by virtue of consent. (Record, p. 66.) The

proceedings at this time were, therefore, regular only in so far as consented to, and their regularity and admissibility is co-extensive with that consent. That consent, however, was only "in so far as the same were *material.*" It necessarily follows that there was no consent to the introduction of any such evidence as was not material. The final decree did not tend to prove any allegation of the bill; it was, therefore, not material to the cause. Now, even conceding that "relevant" would have been a more apt word, still, the terms "relevant" and "material" so run into one another that it is difficult to define one by a definition that would be exclusive of the other, and they are often used by courts interchangeably. For instance, in the case of *Blanchard* v. *Putnam*, 8 Wall., on page 425, this court speaks of an issue not involved in the pleadings as an "immaterial issue." See also quotation from *Ferguson* v. *Ferguson* (*infra*). At any rate, no fact can be "material" that does not tend to prove an issue made by the pleadings. "In equity it [a material issue] "is an issue upon a fact that has some bearing upon the "equity sought to be established." *Wooden* v. *Wolfe*, 6 How. Pr., 145.

The court says (Opinion, p. 9) that "The evident "meaning of the stipulation is that the matters offered "should all be received in evidence, subject only to the "question of *their bearing* upon the merits of the contro- "versy." (The italics are ours.) Now, a fact for the proof of which there is no foundation in the pleadings, concerning which there is no allegation in the bill, can have no bearing upon the decree in a court of equity, as we shall show fully hereafter. The court says "It was a waiver of all formal objection." But we shall also show that no such "formal objection" was necessary. Leaving, then, this question, we will consider briefly the other two

points: that it was not necessary to state any grounds of objection; and that it was not necessary even to note any objection whatever.

Coming, then, to a consideration of the proposition first laid down herein, we will briefly consider the authorities cited.

A large number of additional cases might be cited, but in citing the above we have taken only those cases where it appears that only a general objection was taken to the evidence, or where there is nothing to show whether any objection at all was taken at the time the evidence was offered, or where it affirmatively appears that no objection at all was taken. **In all the cases the rule is laid down, without qualification and without the slightest reference to whether objection was taken or not, that in chancery no decree can be based, and no relief granted, except upon and according to the allegations of the bill.** We shall quote from only a few, contenting ourselves with assuring the court that the other cases support the view taken in those we quote, and further with saying that in a long and laborious search we *have found not one decision of a court where the English chancery practice prevails, in which a contrary doctrine is announced*, or *where it is intimated that such specific objection must be taken to evidence for which no foundation was laid by an allegation in the bill, or even that any objection at all must be taken at the time such evidence is offered.*

In the case of *James* v. *McKernon*, 6 John, 543, the bill was filed by appellee against appellant in the court below for an accounting. The defendant in answer set up an agreement under seal in defense. Evidence was taken on behalf of complainant to show that such agreement was fraudulently obtained, and no objection was taken in the court below or on the hearing to the introduction of such

evidence. A decree was entered on behalf of complainant in the court below. On appeal, Kent, Ch. J., held that the evidence of fraud could not be considered, because no allegations were made in the bill of fraud in the procuring of said agreement; that such allegations of fraud could not be replied, special replications having gone out of use, but could and should have been set up by amendment to the bill or by supplemental bill. On p. 565 the court says: **"It is not a sufficient answer to the objec- "tion in this case, that it must be deemed to have been "waived because not raised at the hearing. The counsel "might well have presumed that the testimony which "looked to that point would not have been taken into "consideration."** And the decree of the court below was accordingly reversed.

In the case of *Thomas* v. *Austin*, 4 Barb., p. 273, in speaking of evidence introduced in the case, but not within any issue framed by the pleadings, the court says: "It "is well settled that such evidence, *though it may have been* "*received without objection, must be disregarded at the hear-* "*ing, and that a decree founded upon that evidence must* "*be reversed.*" (Affirming *James* v. *McKernon*, *supra.*)

In the case of *Ferguson* v. *Ferguson*, 2 N. Y., 361, a bill was filed to foreclose a mortgage. In addition to the breach alleged in the bill, evidence was introduced looking to breaches of the covenant at a period subsequent to the filing of the bill. No supplemental pleadings were filed, and the evidence of such breach was introduced without objection. The court held, reversing the decision of the court below, that "That evidence should not have "been taken into consideration, though not objected to; "for counsel might have presumed that such testimony "would have been deemed *irrelevant* and *immaterial.*"

This opinion cites in support of the above *Crockett* v. *Lee*, 7 Wheat., 522, and affirms *James* v. *McKernon*, *supra*.

The case of *James* v. *McKernon* is cited approvingly in:

14 John., 42, 501, 516–517.
18 John., 558.
19 John., 505.
1 Cow., 734.
2 Cow., 172.
3 Wend., 584, 653.
26 Wend., 165.
5 John. Ch., 83.
7 Paige, 490.
2 Edw., 447.
2 N. Y., 361 (363); 506.
2 Barb., 565.
4 Barb., 273, 313.
6 Barb., 146, 162, 654.
7 Barb., 406.
10 Barb., 270.
20 Barb., 473.

And by this court in:

10 Pet., 209–211.
7 How., U. S., 159.

And was the uniform doctrine laid down by the New York courts until the practice in New York was changed by the New York Code of Procedure. We cite these New York cases both because the opinion quoted from *James* v. *McKernon* was rendered by Chancellor Kent, and for other reasons which we will consider hereafter.

In Story on Equity Pleadings, § 257, it is said:

"Every fact essential to plaintiff's title to maintain the "bill, and obtain the relief, must be stated in the bill, "otherwise the defect will be fatal, for no facts are prop- "erly in issue unless charged in the bill; and, of course, "no proofs can be generally offered of facts not in the "bill; nor can relief be granted for matters not charged, "*although they may be apparent from other parts of the*

"*pleadings and evidence;* for the court pronounces its de-
"cree *secundum allegata et probata.*"

In the case of *Harrison et al.* v. *Nixon et al.*, 9 Pet., 483, the bill was filed for the distribution of personal estate bequeathed by the decedent to his heir at law. The bill contained allegations as to the citizenship of the testator, but no allegations as to domicile. Reference was had to a Master, where full proofs were had, and the court below rendered a decree distributing the estate. On appeal, the court, in an opinion by Mr. Justice Story, says, p. 502–3: "The bill contains no averment of the "actual domicile of the testator at the time of the making "of his will, or at the time of his death, or any inter-"mediate period. Nor does the answer contain any aver-"ments of domicile, which supply these defects in the "bill, even if it could do so, as we are of opinion, in "point of law, it could not. . . . The proofs must "be according to the allegations of the parties: and if "the proofs go to matters not within the allegations, the "court cannot judicially act upon them as a ground for "its decision: for the pleadings do not put them in con-"testation. The *allegata* and *probata* must reciprocally "meet to conform to each other." And the case was reversed and remanded. Yet it appears from the dissenting opinin of Mr. Justice Baldwin, page 506, that this was done "on an objection not taken by counsel, either in "the Circuit Court or assigned for error here in the "printed brief of their points, presented to this court "as the ground of a reversal of the decree of which the "appellants complain." This point was raised by the court of its own motion, and the case was reversed.

The case of *Crockett* v. *Lee*, 7 Wheat., 522, is absolutely decisive of this question. In that case the controversy turned upon the validity of a certificate for a settle-

ment right of land, which, it was claimed by Lee, was invalid because of the indefiniteness of description—an indefiniteness which did not appear upon the face of the certificate, but which arose only upon evidence of extrinsic facts. If that certificate was invalid, Lee took the title; if the certificate was valid, Crockett took it. *In the court below the proof of both parties, without objection, was directed largely to this question*—to the indefiniteness of the description in the certificate and its consequent invalidity—and a decree was rendered by the court below in favor of Lee on this ground. The Supreme Court of the United States, on appeal by Crockett, reversed the decree of the court below solely because there were no allegations in the pleadings of this indefiniteness; although the court admits in its opinion that the evidence, if properly admissible, supported the decree (p. 528.) The opinion of the court is by Mr. Chief Justice Marshall, and, on page 525, he says:

"The testimony which has been taken in these causes, "certainly is very strong in support of the decrees of "the Circuit Court; but the counsel for the appellant "contends that so much of this testimony as respects "the vagueness of Cameron's location must be disregarded, "because neither its vagueness nor its certainty has "been put in issue. Lee has not averred in his bill, nor "alleged in his answer, that this location is vague, nor "has he anywhere, or in any manner, questioned its validity.

"The principle advanced by the appellant's counsel "can not be controverted. No rule is better settled than "that the decree must conform to the allegations, as well "as to the proofs in the cause. The location being set "out in the pleadings, the court can undoubtedly notice "any intrinsic apparent defect. If it be void in itself, no

"*pleadings and evidence;* for the court pronounces its de-"cree *secundum allegata et probata.*"

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"The principle advanced by the appellant's counsel "can not be controverted. No rule is better settled than "that the decree must conform to the allegations, as well "as to the proofs in the cause. The location being set "out in the pleadings, the court can undoubtedly notice "any intrinsic apparent defect. If it be void in itself, no

"testimony can sustain it, and it would be deemed void "on a demurrer to the bill. But if it be not void in it- "self, if its validity depends upon facts to be proved in "the cause, then its validity ought to be put in issue.

. . . . . .

"*The counsel for the appellant (sic) says it would be "monstrous, if, after the parties had gone to trial on the "validity of the entry, and have directed all their testi- "timony in the Circuit Court to that point, their rights "should be made to depend in the Appellate Court on a "mere defect in pleadings, which had entirely escaped "their observation in the court where it might have been "amended, and the non-existence of which would not have "varied the case.*

"*The hardships of a particular case would not justify "this tribunal in prostrating the fundamental rules of a "court of chancery; rules which have been established for "ages, on the soundest and clearest principles of general "utility.* If the pleadings in the cause were to give no "notice to the parties or to the court of the material facts "on which the right asserted was to depend, no notice of "the points to which the testimony was to be directed, "and to which it was to be limited; if a new case might "be made out in proof, differing from that stated in the "pleadings, all will perceive the confusion and uncertainty "which would attend legal proceedings, and the injustice "which must frequently take place. *The rule that the "decree must conform to the allegations, as well as to the "proofs of the parties, is not only one which justice re- "quires, but one which necessity imposes on courts. We "cannot dispense with it in this case.*"

This case, we conceive, is absolutely conclusive in favor of appellant of the point in issue. It has been cited in a

number of other cases in the Supreme Court of the United States, and never overruled, as we believe.

We come, then, to a consideration of the cases which are supposed to announce a doctrine contrary to that which we have above laid down. Before considering them, however, we wish to call the attention of the court to two points:

1. In all chancery cases in the United States courts, the practice of the Courts of King's Bench and of Chancery, in England, is the basis of equity practice, except so far as modified by the rules of this court.

Rules of the Supreme Court, Rule 3.

Vattier v. *Hinde*, 7 Pet., 252.

Waring v. *Clarke*, 5 How., p. 475.

Fenn v *Holme*, 21 How., 481.

Kirby v. *L. S. Ry.*, and authorities cited, 120 U. S., p. 138.

Pennsylvania v. *W. & B. Bridge Co.*, 13 How., 518, p. 563.

Payne v *Hook*, 7 Wall., 425.

In the case of *Payne* v. *Hook*, 7 Wall., 425 (p. 430), it was said: "We have repeatedly held that 'the jurisdiction of the courts of the United States over controversies between citizens of different states cannot be impaired by the laws of the states which prescribe the modes of redress in their courts or which regulate the distribution of their judicial power.' If legal remedies are sometimes modified to suit the changes in the laws of the states and the practice of their courts, it is not so with equitable. The equity jurisdiction conferred on the Federal courts is the same as that the high court of chancery in England possesses, is subject to neither limitation or restraint by state legislation, and is uniform throughout the different states of the Union."

In his work on the Jurisdiction of Courts of the United States, p. 13, Mr. Justice Curtis said: "The equity "practice of the courts of the United States is the same "everywhere in the United States, and they administer "the same system of equity rules and equity jurisdiction "throughout the whole of the United States, without re- "gard to state laws." And this statement is quoted and approved by this court in *Kirby* v. *Lake Shore &c. Ry.*, 120 U. S., p. 137.

It is obvious, then, that the decisions of only those courts which retain the English equity practice can be of any authority or have any weight in deciding a question of chancery practice in the Federal courts. *It is further obvious that the decisions of those states in which the practice is regulated by a Code of Procedure, and the decisions in cases based upon the practice of such states, can be of no authority and can have no weight in deciding a question of chancery practice in the Federal courts.*

2. We briefly call the attention of the court to the fact that there is a fundamental difference between a judgment at law and a decree in chancery, and arising out of that a difference between common law and equity practice.

That difference is that a judgment at law is presumed on appeal to have been founded on sufficient evidence, unless the contrary appears, and a bill of exceptions is essential; while chancery practice knows of no such thing as a bill of exceptions, and the decree is presumed to be not supported by the evidence, unless evidence supporting it is preserved of record. This arises, evidently, from the old chancery practice, in which all proofs were taken by deposition, reduced to writing, and produced upon the hearing of the cause. It also follows

from this practice that it is unnecessary to preserve any objection to evidence upon the ground of its irrelevancy or immateriality, as it will be presumed that the court upon the hearing will consider only such proofs as are relevant or material to the issues formed by the pleadings, and, as we have seen, if the decree is founded upon proofs for which no basis is found in the pleadings, that decree must be reversed.

James v. *McKernan*, *supra*.
Thomas v. *Austen*, 4 Barb., 273.
Ferguson v. *Ferguson*, 2 N. Y., 361.
Crocket v. *Lee*, *supra*.
Swift v. *Castle*, 23 Ill., 132.
White v. *Morrison*, 11 Ill., 361.
Pankey v. *Raum*, 51 Ill., 88.
Thomas v. *Adams*, 59 Ill., 223.

With these two points in view, let us look at the two cases relied upon by the Circuit Court of Appeals in support of its opinion. The first case cited by them in their original opinion is the case of *Walsh* v. *Colclough*, 56 F. R., 778. That was a case at law arising in Wisconsin and consequently tried under the Wisconsin Code of Procedure. Four Wisconsin cases are cited in that case as supporting the announced doctrine in that case, in neither of which, however, was the point in question adjudicated. It was, however, considered and decided as laid down in the case of *Walsh* v. *Colclough*, in the case of *Boreman* v. *Van Kuren*, 29 Wis., 209. In all these Wisconsin cases, however, the decisions were based wholly upon two provisions of the Wisconsin Code of Procedure (Rev. Stat., 2669–2670), which provide in substance, first, that no variance between pleading and proof shall be deemed material unless it shall actually mislead the adverse party to his prejudice in maintaining his action or defense; and

where it is alleged and *proven* that a party has been so misled, and in what respect, then the court may order amendment upon terms; and, second, that where a variance is not material, as provided in the last section, the court may direct the fact to be found in accordance with the evidence, or may order amendment without costs.

Of these two sections of the Code, the Wisconsin court says, in *Knowlton* v. *Bouron*, 7 Wis., 500: "The Code "has greatly mitigated the consequences of a variance "between pleadings and proofs, and its provisions in this "respect were salutary."

This, we submit, effectually disposes of the case of *Walsh* v. *Colclough*, and of the decisions upon which that case is made. It is doubtless true that a number of cases can be found announcing substantially the same doctrine as that announced in *Walsh* v. *Colclough*, but an examination of all these cases will show that they are either law cases and based upon liberal statutes of amendments and jeofails, or, in equity cases, are based upon Code provisions similar to those above quoted.

We come, then, to the consideration of the case of the *Wasatch Mining Co.* v. *Crescent Mining Co.*, which the Circuit Court of Appeals says decides contrary to and overrules the case of *Crocket* v. *Lee* (*supra*). We submit, with all deference, that that case does nothing of the kind.

The case was heard in the U. S. Supreme Court on appeal from the decision of the Supreme Court of the Territory of Utah. The original case was a petition filed in the District Court of the Third Judicial District of Utah Territory, under the provisions of the Utah Code. For this reason alone it can have no application to a case arising under and based upon the general principles of chancery practice independent of a Code, and has no more

application than the Wisconsin decisions which we attempted to dispose of in our petition. The case is reported as *Crescent Mining Company, Appellee*, v. *Wasatch Mining Company, Appellant*, 5 Utah, 624. In that case the complaint was filed under the Code for the reformation of a deed so as to include certain lands not included in the deed and alleged in the complaint to have been omitted therefrom by the fraud of the defendant and by the mistake and inadvertance of the complainant. The answer of the defendant (see pp. 633–634) *denied that it was the intention of the parties to include the missing property in the deed, and denied that it was within the terms of the contract upon which the deed was based.* The evidence showed that it was the intention of the parties to include the lands, and that it was omitted by mistake, but no actual fraud of the defendant was proven. A decree was entered for the plaintiff, and the defendant urged on appeal that the case should be reversed, because the complaint charged fraud and the evidence showed only mistake. The Supreme Court of the Territory of Utah held that such evidence went in without objection (5 Utah, p. 634); that the defendant itself brought the facts before the court by its pleadings, and that the objection could not be urged for the first time in the appellate tribunal. On appeal to the Supreme Court of the United States, that court held that the Supreme Court of Utah had correctly decided the case, and cites and quotes from, as supporting it, the case of *Tyng* v. *Commercial Warehouse Company*, 58 N. Y., 308–313.

The case last mentioned was a case at law, and, as we have said, arose under the New York Code of Procedure. The doctrine announced by the New York court in that case, and quoted by the Supreme Court in the case of *Wasatch Mining Co.* v. *Crescent Mining Co.*, is based

upon three decisions which the New York Court of Appeals cited. These are:

Callen v. *Gunter*, 11 N. Y., 368.
Miller v. *Schuyler*, 20 N. Y., 524; and
McKeough v. *Devlin*, 52 N. Y., 399.

Referring to the case of *Callen* v. *Gunter*, the first of the three, we find that the question involved in that case was a question almost identical with that involved in *Tyng* v. *The Commercial Warehouse Co.* The court below had found that there was a variance between the allegations of the defendant and his proofs, and on appeal the New York Court of Appeals says (p. 373): "If the "Code of Procedure had not changed the rule which is to "govern this case, the court below was clearly right in "holding, as it did, that there was a fatal variance. The "cases are uniform and consistent. . . . The Code, "however, contains provisions on the subject of a var- "iance *applicable to all actions;* and if they establish a "different rule from the one recognized in these cases, "we are bound to apply it, though thereby the plaintiff "may suffer loss, which, by defendant's slip in pleading, "he would have avoided under the former rule." (The italics are ours.) The court then proceeds to quote the provisions of the New York Code as to a variance applicable to all cases arising under the Code. These provisions we do not quote in full, but they are almost identical in wording, and are identical in effect with the provisions of the Wisconsin Code above quoted from, which are evidently taken from the provisions of the New York Code.

The court then, on p. 374, says: "These provisions "introduce a principle unknown to the former practice, "namely, that of determining this class of questions, not "by the incoherence of the two statements upon their

"face, and hence inferring their effect upon the state of "the preparation of the party, but by proof *aliunde*, as "to whether the party was actually misled to his preju- "dice." The variance was accordingly held immaterial, and the decision of the court below reversed. It is obvious, then, that the case of *Wasatch Mining Co.* v. *Crescent Mining Co.*, arising, as it does, under a Code, and being based, as it is, upon the decisions under the Code of a court which had uniformly decided precisely the contrary before that Code was adopted, *and which bases its new line of decisions wholly upon the change in the practice made by that Code*, does not and cannot overturn the doctrine laid down in the case of *Crockett* v. *Lee*, and the other cases cited above.

The Utah Code is not accessible to us in preparing this brief, and we cannot, therefore, quote the parts of that Code applicable to the practice in Utah. But we are informed and believe that that Code contains provisions similar to the New York Code. Indeed, it is well known that the New York Code of Procedure was the basis of the various Codes which have been subsequently enacted in the various states now regulating their practice by a Code, and was in many of its parts re-enacted almost word for word. We, therefore, insist that the case of the *Wasatch Mining Co.* v. *Crescent Mining Co.* does not and cannot overrule *Crockett* v. *Lee*. Although the case of *Crockett* v. *Lee* was cited by appellants in their

light of the case of *Crockett* v. *Lee*, by saying that it was decided in 1822, and, in substance, that parties are no longer made to depend for their rights upon technicalities in pleadings, and are not turned out of court because they fail to dot their i's and cross their t's. That may be true. But if any change has been made in the general rules of chancery proceedings, it has been made only by virtue of statutory enactments, changing and mitigating the rules of law in force prior to such enactment. We have cited and quoted from the decisions of Marshall, Story and Kent; the authority of these three names should settle a question of chancery practice, unless changed by statute. No statutory provision can be found in the United States Statutes changing the rule laid down in *Crockett* v. *Lee*, and no new rule of court has been announced since that time changing that doctrine.

To one further point we briefly call the attention of the court. The introduction of the estoppel into this case by appellee has been spoken of as a "variance." It is not a mere variance, by any means. The appellee made out its case as alleged in its bill fully and completely, and without variance from the allegations in the bill, and its allegations were sustained by that proof, except in so far as contradicted by evidence of appellants. Upon that case, so made out and without a variance, *it sought, without any attempt to amend or file a supplemental bill, to impose a new, complete and wholly different case*—a case which of itself, without any reference to the other case made in the bill, would be, upon proper pleadings, decisive; a case which was not merely variant from but *wholly without any foundation in the bill whatever*, and asked for a relief not founded upon or in any way connected with any allegation of that bill, and not anywhere

in that bill prayed for. We submit that this is not a case of mere "variance."

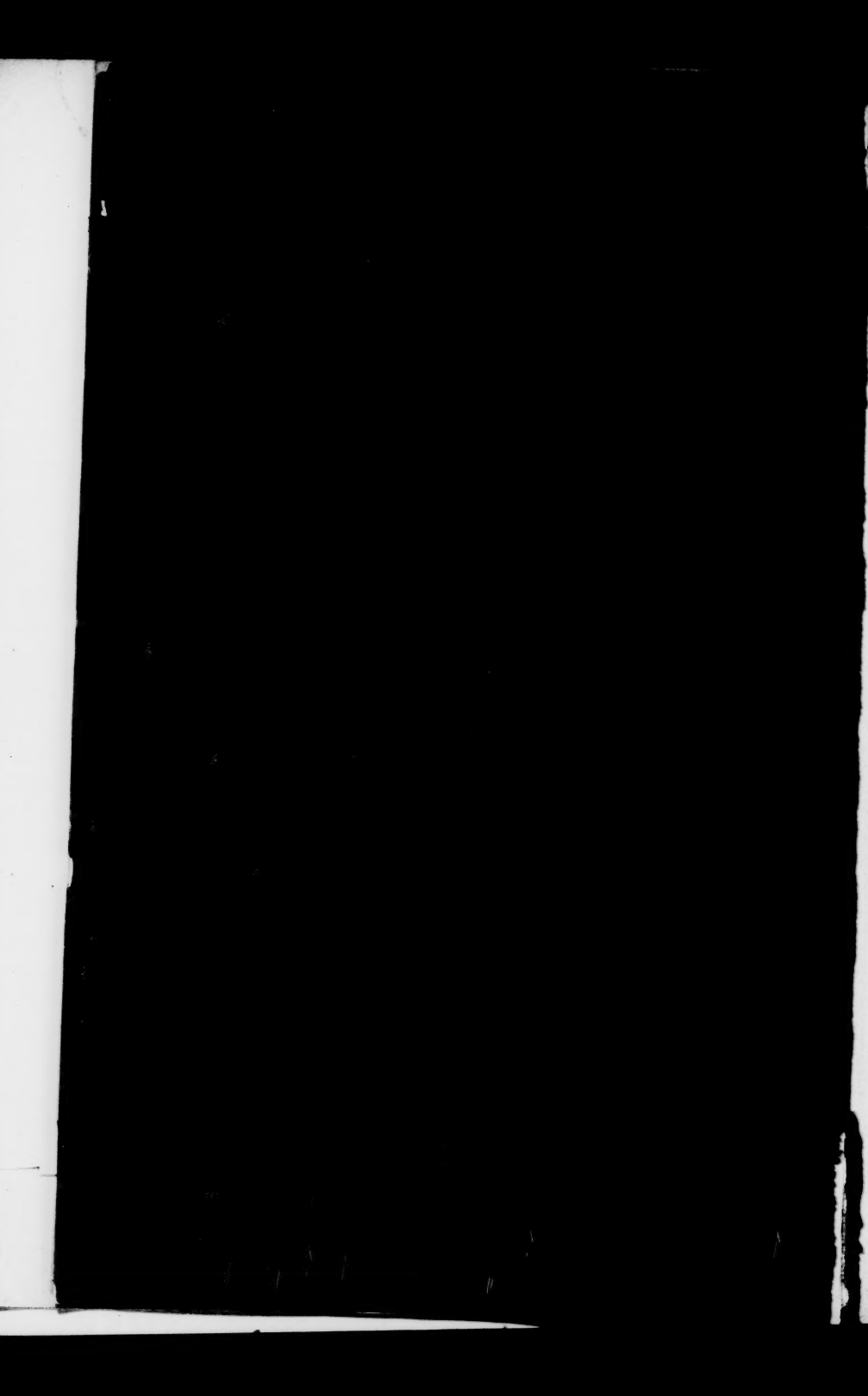
We are aware that it is the doctrine of this court not to grant writs of *certiorari*, and thus review decisions of the Circuit Court of Appeals, except in important cases. We respectfully submit that this is a case of such importance as to justify the intervention of this court. It is a case of great hardship upon appellants, who have been prevented, by a decision which we believe has misconstrued the law, from making a defense upon the merits of the controversy to a patent since held invalid by this court. It involves a question of general chancery practice applicable to the practice of all Federal courts in this country, and regulating the chancery practice therein, which is supposed to be and should be "uniform." Upon this question of chancery practice we believe that the Circuit Court of Appeals has announced a doctrine precisely contrary to the doctrine universally laid down theretofore in chancery cases, a doctrine which overrules the decisions of this court and establishes a new rule of law by mere "judicial legislation." We therefore respectfully submit that this question is one of such importance that this court should pass upon it and settle it in one way or the other, once for all.

Respectfully submitted,

L. L. Bond,

C. E. Pickard,

Counsel for Petitioners.



Supreme Court of the United States.

OCTOBER TERM, A. D. 1893.

IN THE MATTER OF THE APPLICATION OF THE DAVID BRADLEY MANUFACTURING COMPANY, AND THE MOLINE PLOW COMPANY, FOR WRITS OF CERTIORARI.

BRIEF IN OPPOSITION TO APPLICATION.

The brief in support of the petition for the writs professes to be based upon a desire of petitioners to have this Court pass upon the well-known chancery rule that the relief must be based upon and follow the proofs and the allegations of the bill. There are several reasons why the writs should not issue. A controlling one is that no such question is presented by the records. On the contrary, the record shows conclusively that the relief granted follows both the proofs and the allegations, and does not go beyond either. The bill in each case alleges, among other things, the issuance of a patent for certain improvements of which the patentee is alleged to be the first inventor, the infringement of the patent by the defendant, and prays for an injunction and an accounting. The answer in substance denies that the patentee was the first inventor, setting up many alleged anticipations, attacks the validity of the patent, and denies the infringement thereof. The issues thus presented to the Court for determination were, broadly stated, the validity of the patent, including, necessarily, questions of novelty and

anticipation, and the infringement thereof. Among other proofs offered by the complainant were a prior decree between the complainant and another company, evidence that the defendant was the real party in interest in the prior suit, and defended the same, and were engaged in making the same cultivator held to be an infringement in the prior suit. The decree thus offered directly and conclusively proved the validity of the patent sued on in both suits and the infringement thereof.

The relief granted, the injunction and accounting, simply followed the allegations and the proof. Hence we say that the great question of chancery practice which petitioners profess to raise for determination by this Court is not and can not be presented by the records, and that the numerous decisions quoted by them are not pertinent. There are, however, certain questions of pleading and evidence presented by the record as to which opposing counsel may hope for an expression of the opinion of this Court, but they lie outside of the question professedly offered to this Court for determination.

The real question which the record presents, and which opposing counsel hope for a decision upon, pertains to the action of the Court in holding the prior decree conclusive evidence of the matters within its purview. They assert that the prior decree was not pleaded, and hence claim that the decree, though admitted in evidence by their express consent, should not have been held to be conclusive. Conceding at present, for the sake of argument, that the prior decree was not pleaded, the question arises as to the effect of this decree as evidence. To exclude it from consideration, and deprive it of its conclu-

sive effect as evidence, counsel assume that a bill in equity must allege not only the ultimate facts constituting the grounds for relief, but also the evidence to prove those facts. This is clearly an unwarranted assumption. While undoubtedly the bill must allege the ultimate facts, "A general charge or statement, however, of the matters "of fact is sufficient; and it is not necessary to charge "minutely all the circumstances which may conduce to "prove the general charge, for these circumstances are "properly matters of evidence which need not be charged "to let them in as proofs."

Story, Eq. Pleading, 10 Ed. Sec. 28.

The issues in the suit were the validity of the patent and its infringement. The prior decree was *evidence* directly in point on these issues. While there is a conflict as to the effect of a decree offered in evidence, without being pleading, the decisions are practically united in holding that the former decree is admissible in evidence whenever it has a bearing upon the issues.

Foye v. *Patch, 132 Mass., 110.*
Krekeler v. *Ritter, 62 N. Y., 374.*
Marston v. *Swett, 66, N. Y., 206.*

In *Marston* v. *Swett*, the validity of a patent was put in issue, and a former judgment holding the patent invalid was admitted in evidence, without being pleaded. The Court held that the judgment was proof of the issue, and therefore proper evidence, it not being necessary to plead evidence. A multitude of other cases to the same effect might be cited, but a few will illustrate the rule as well as many. Where the prior judgment does

not bear on the issues, and is in the nature of matter in confession and avoidance, as a discharge in bankruptcy, it is held that it should be pleaded to be admissible in evidence.

Foye v. *Patch, 132 Mass., 110.*

The great conflict of authority is in regard to the *effect* of the decree. In the *Duchess of Kinston case, 11 State Trials, 261,* it was held to be "as a plea, a bar, or as evi- "dence conclusive." While this case was followed in a number of other cases, yet the preponderance of authority in England held that a former judgment, offered in evidence, but not pleaded, was not conclusive, and that the jury could follow it or disregard it, as might suit their caprice. The inconsistency of the rule which bound the Court by the decree, when pleaded, and permitted the jury to disregard it when offered in evidence, has been pointed out in the opinion of judges, and in the text books.

Freeman on Judgments, 2 Ed., Sec. 284.
Black on Judgments, Sec. 783 to 789.
Bigelow on Estoppel, Chap. 21.
Greenleaf on Evidence, Vol, I., Sec. 531.

The English courts fell into this inconsistent rule, owing to the form of the oath administered to the jury in olden times, when jurors were supposed to have a personal knowledge of the cases before them, and to base their verdicts upon such knowledge as well as the evidence introduced. The jurors were then sworn to "say the truth," instead of, as now, to render a verdict according to the evidence. Hence it was held that they could disregard a

prior judgment if it did not comply with their ideas of the truth. On this point see *Bigelow on Estoppel, Chap. 21.*

The English rule was subject to exceptions even by the courts professing to follow it. Thus in *Bird* v. *Randall, 3 Burr, 1353,* we find Lord Mansfield giving effect to a former recovery, without being pleaded, in an action of case, and the reason he gave was that an action in case "is in the nature of a bill in equity, and in effect is so."

The English rule, with some modifications, was followed by the courts of Massachusetts, New York, and a few other courts, but the weight of authority in this country is in accord with the Duchess of Kingston case, holding the former decree conclusive as evidence, though not pleaded. The American and English cases are cited at great length in the text-books. We will call attention to one of these cases on account of the able and unanswerable opinion of the Court.

Marsh v. *Pier, 4 Rawle, 279.*

Counsel for petitioners cite a number of cases, some in point, and some not, being cases of estoppel in pais.

The American cases which followed the English rule gave as a reason for holding the former recovery inconclusive where offered in evidence merely, that if the party did not plead the former recovery as a bar or estoppel he waived its conclusive effect as such, and it became evidence merely, and not conclusive evidence.

The reasoning is faulty in two ways. *First,* it violates the principles of pleading in requiring evidence to be pleaded in addition to the ultimate facts constituting the

party's case. *Second,* it treats the matter as one concerning the parties only, and leaves out the public. It is a matter of public importance that there should be an end to litigation, and when the evidence discloses a prior adjudication of the controversy, courts will and should give full effect to it. On this point see *Marsh* v. *Pier, supra.*

While the New York court has not formally overruled its old decisions following the English rule, it has practically done so. It now holds that a prior judgment which tends to prove the issues in the case is proper and conclusive evidence, and being evidence need not be pleaded.

Krekeler v. *Ritter, supra.*
Marston v. *Swett, supra.*

In Massachusetts the court took advantage of the adoption of a practice act to escape from its old decisions, and to hold that evidence need not be pleaded; that a prior judgment, if bearing on the issues, was proper and conclusive evidence.

Foye v. *Patch, supra.*

The change in ruling is based upon the practice act, but the reasons given apply with equal force to common law or equity pleadings. The same question was before this Court in *Young* v. *Black, 7 Cranch, 565,* where in an action of assumpsit a former judgment was admitted in evidence and held to be conclusive, though not pleaded. Conclusive effect was also given to a former decree offered in evidence in *Thompson* v. *Roberts, 24 How. 233,* though the question of pleading does not appear to have been presented.

Counsel for petitioners argue their case as though the Appellate Court had held that the prior decree was not pleaded, and hence could not be given in evidence and considered, except by the consent of the opposite party. It is true that in the first opinion of the Appellate Court it is held that a prior recovery should be pleaded, and that the pleading in this respect was *technically* defective, but the Court also held that the pleading in substance complied with the spirit of the law, informing the opposite party of what was relied upon. The Court also held that the petitioners, not having attacked in any way the defective character of the pleading, and having consented to the introduction of the decree in evidence, waived all right to object to the Court considering the decree and giving it due effect. In its opinion upon rehearing the Court held that *if* it was ever necessary to plead the decree, the petitioners had waived their rights in the matter. The Court then holds most emphatically that no plea of the prior decree was necessary; that it was evidence directly proving the issues in the case, and entitled to full force and effect. We submit that the Appellate Court was clearly right upon both points. While there is no variance between the allegations, proofs, and relief, yet, if the failure to plead this evidence (the decree) is to be treated as similar to a variance, the modern decisions unite in holding that a litigant cannot, without *proper* objection on his part, go to trial upon one issue in the trial court and in the Appellate Court ask to have the Court try the case on a different issue, or on different evidence. There are often technical variances between the pleadings and the controversies actually tried and determined, in both law and equity cases. If objection is

made in the trial court, the variance can be cured by amendment. If no objection is made the defect is waived.

Davis v. *Patrick*, *141 U. S., 490.*

Wasatch Mining Co. v. *Crescent Mining Co., 148 U. S., 300.*

In this case the petitioners, without attacking the sufficiency of the pleading, expressly consented to the introduction of the decree, and thus invited the trial court to pass upon the effect of the decree. After being defeated they ask an Appellate Court to exclude the decree and pass upon a different case. Their conduct in this respect furnishes an additional reason why this Court should not exercise its discretionary and extraordinary power of issuing writs of *certiorari*.

On the second point decided by the Appellate Court, that the decree was evidence of the allegations of the bill, and therefore need not be pleaded, the Court is supported by reason, by the preponderance of authority, and by the direct decision of this Court in *Young* v. *Black*, *supra*.

In conclusion, we wish to suggest the question whether this is a case where it is wise and proper to remove the proceedings to this Court. It presents merely questions of evidence and practice. It presents no *new* questions the determination of which is of public importance. The allowance of the writs would encourage all defeated parties in unappealable cases to apply to this Court for another trial.

Respectfully submitted,

GEO. H. CHRISTY,

NATH. FRENCH,

Counsel for Respondent.

(154 U.S. 552)

RECORD, CASE No. 16[illegible]

SUPREME COURT OF THE UNITED [illegible]

OCTOBER TERM, 1894.

TERM No., 1016.

FONG LOUIE, APPELLANT,

vs.

THE UNITED STATES AND GEORGE E. GARD[illegible] STATES MARSHAL FOR THE SOUTHERN [illegible] CALIFORNIA.

APPEAL FROM THE DISTRICT COURT OF THE UNITED [illegible] THE NORTHERN DISTRICT OF CALIFORNIA.

FILED SEPTEMBER 22, 1894.

1 United States District Court, Northern District of California.

In the Matter of the Application of FONG LOUIE for a Writ of *Habeas Corpus*. No. 10738.

To the honorable the district court of the United States in and for the northern district of California, ninth circuit:

And now comes Fong Louie and makes this his petition and complaint to this honorable court, and respectfully shows:

I. That your petitioner is a person of the Chinese race, born in China, and not a naturalized citizen of the United States, and that at all the times hereinafter mentioned, and more especially at the time of the passage of the act of Congress approved May 5th, 1892, and entitled "An act to prohibit the coming of Chinese persons into the United States," he was, always has been and still is a Chinese person of the exempt class within the limits of the United States and entitled to remain in the United States, in that he was within the United States at the time of the passage of the act of Congress approved May 6th, 1882, and entitled "An act to execute certain treaty stipulations relating to Chinese," and has never thereafter and up to the time of making this his petition been without the United States, and that he now resides, and has resided for more than one year last past, in the county of Los Angeles, in the southern district of California.

II. That your petitioner on the 17th day of November, 1880, the day the treaty between the United States and China concerning immigration was concluded and signed, was within the United States, and was under the terms of said treaty accorded all the rights, privileges, immunities and exemptions which were then accorded to the citizens and subjects of the most favored nation, and prior to said last-named day, and in or about the month of July, 1879, had come to the United States with the intention of remaining and taking up his permanent residence therein, and with no definite intention of returning to China, and at the time of said treaty had become and has ever since been a permanent resident of the United States under and in pursuance of the invitation extended to him and at that time to all other Chinamen under the provisions of the fifth and sixth articles of the additional articles to the treaty between the United States of America and the Ta Tsing empire of the 18th of June, 1858, concluded and signed on the 28th day of July, 1868 (Burlingame treaty), which then and there declared that the high contracting parties "cordially recognize the inherent and inalienable right of man to change his home and allegiance,

2 and also the mutual advantage of the free migration and emigration of their citizens and subjects respectively from the one country to the other, for purposes of curiosity, of trade, or of permanent residents," and further declared that "Chinese subjects * * * residing in the United States shall enjoy the same privileges, immunities and exemptions in respect to * * * residence as may be there enjoyed by the citizens or subjects of the most favored nation."

III. That heretofore, to wit, on the 3rd day of Sept., 1893, one W. F. Lintner presented to the Honorable E. M. Ross, United States district judge in and for the southern district of California, a complaint verified by him, which charged that your petitioner was a Chinese laborer residing within the southern district of California, and within the jurisdiction and limits of the United States at the time of the passage of an act approved May 5th, 1892, entitled "An act to prohibit the coming of Chinese persons into the United States," and that your petitioner was then and there entitled to remain in the United States, and was after one year from the passage of said act found unlawfully within the jurisdiction of the United States without the certificate of residence provided for in section 6 of said act. That thereupon the said district judge made an order directing that the said complaint be filed, and that a warrant issue, which warrant was thereafter issued and delivered to the marshal of the United States in and for the southern district of California. Copies of said complaint, order and warrant are hereto attached and made part hereof.

That afterwards, to wit, on the 4th day of September, 1893, the said United States marshal apprehended your petitioner and took him into custody and produced him before the said district judge.

IV. That the said W. F. Lintner, who made and presented the complaint hereinabove referred to, is not and was not at any of the times herein mentioned, a customs official, collector or deputy collector of internal revenue, United States marshal or deputy United States marshal, or in any way connected with any of the executive departments of the Government of the United States.

V. That thereafter, on the 6th day of September, 1893, your said petitioner was brought before the district court of the United States in and for the southern district of California, and testimony was introduced on behalf of the Government and on behalf of your petitioner, and the cause thereupon submitted, and on the 8th day of September, 1893, the said district court in and for the southern district of California made an order directing that your petitioner be deported from the United States to China, and remanded your petitioner to the custody of Geo. E. Gard, United States marshal in and for the southern district of California. Copies of said orders are hereto attached and made a part hereof.

VI. That your petitioner is detained and restrained of his liberty by and in the custody of George E. Gard, the marshal of the United States in and for the southern district of California, under and by color of the authority of the United States, wrongfully and unlawfully, as your petitioner is informed and verily believes, and in violation of the provisions of the Constitution of the United States, and of the laws thereof, and of the various treaties made and entered into between the United States of America and the Chinese empire.

VII. That he has not been apprehended and is not detained by virtue of any judgment, order or decree, or other judicial process of any court other than the said order of the said United States judge heretofore referred to herein, and that he is now detained by virtue of the alleged claim and authority given to the said marshal of the

United States in and for the southern district of California by and under said order made by said judge.

3 VIII. That, as your petitioner is informed and verily believes, his detention by the said United States marshal in and for the southern district of California, by and under the direction of the order of said United States judge, is without jurisdiction and void and unconstitutional, and that your petitioner is restrained of his liberty without due process of law and against his rights under the Constitution of the United States and the laws thereof and the various treaties between the United States of America and the Chinese empire, and unlawfully and without authority, under the guise and color of proceedings against him for the commission of the alleged offense against the provisions of the said 6th section of the said act of Congress of May 5th, 1892, to wit, of not having applied to the collector of internal revenue of his district for a certificate of residence and of now being without such certificate of residence, which said alleged offense is not, as this petitioner is informed and verily believes, any offense whatever, in that the whole of said 6th section of said act of Congress of May 5th, 1892, is unconstitutional, void, and of no effect.

IX. That your petitioner is informed and verily believes that his detention by the United States marshal in and for the southern district of California, as aforesaid, is without jurisdiction, and void for the reason that the said W. F. Lintner, who made and presented the complaint hereinabove referred to, was not at any of the times herein mentioned a customs official, collector or deputy collector of internal revenue, United States marshal or deputy United States marshal, and that the filing of said complaint and the issuance of a warrant thereon was without authority of law and in excess of the jurisdiction of the said district judge for the southern district of California, and that all proceedings thereunder were therefore illegal and void.

X. And your petitioner further says that no previous application for a writ of *habeas corpus* has been made by him to this or any other court or judge.

Wherefore your petitioner prays that this honorable court will order a writ of *habeas corpus* to be issued out of this court to said George E. Gard, the marshal of the United States in and for the southern district of California, requiring him to forthwith produce the body of your petitioner before this honorable court, and there to abide what shall be ordered by this honorable court in the premises.

And as in duty bound your petitioner will ever pray.

FONG (Chinese signature) LOUIE.

HARVEY S. BROWN AND
THOS. D. RIORDAN,
Attorneys for Petitioner.

CITY OF SAN FRANCISCO, } ss:
Northern District of California, }

Fong Louie, being duly sworn, deposes and says that he is the petitioner and complainant hereinbefore named; that he has heard read

and translated to him the foregoing petition and complaint and knows the contents thereof, and that the same is true of his own knowledge except as to those matters which are therein stated on his information or belief, and that as to those matters he believes it to be true.

FONG (Chinese signature) LOUIE.

Subscribed and sworn to before me this 11th day of September, 1893.

[SEAL.] JNO. F. LYONS,
Notary Public in and for the City and County of San Francisco, State of California.

4 [Endorsed:] No. 10738. U. S. district court, northern district of California. *In re* application of Fong Louie for writ of *habeas corpus*. Petition for writ. Filed September —, 1893. —— ——, clerk, by —— ——, deputy clerk. Harvey S. Brown and Thos. D. Riordan, attorneys for petitioners.

5 UNITED STATES OF AMERICA, *Southern District of California,* } *ss:*

Be it remembered that on this 31st day of August, in the year of our Lord one thousand eight hundred and ninety-three, before me, William M. Van Dyke, a commissioner duly appointed by the circuit court of the United States of America for the southern district of California to take acknowledgments of bail and affidavits, and also to take depositions of witnesses in civil causes depending in the courts of the United States, etc., pursuant to the acts of Congress in that behalf, personally appeared W. F. Lintner, who, being duly sworn according to law, deposes and says that Fong Louie, being a Chinese laborer at and residing in the county of Los Angeles, State of California, within the southern district of California and within the jurisdiction and limits of the United States at the time of the passage of an act approved May 5th, 1892, entitled "An act to prohibit the coming of Chinese persons into the United States," and who was then and there entitled to remain in the United States, was, after one year from the passage of said act, to wit, on the 30th day of August, A. D. 1893, found unlawfully within the jurisdiction of the United States, to wit, at the county of Los Angeles, State of California, without the certificate of residence provided for in said act.

He, the said Fong Louie, still is and was residing in said county and State and in the first collection district of California during all the time within one year after the passage of said act—

6 Contrary to the form of the statutes of the United States in such case made and provided and against the peace and dignity of the said United States.

W. F. LINTNER.

Sworn to and subscribed this 31st day of August, 1893, before me—
WM. M. VAN DYKE,
Commissioner of U. S. Circuit Court,
Southern District of California.

Let the foregoing complaint be filed and a warrant issued.
E. M. ROSS,
Dist. Judge.

(Endorsed:) No. 470. U. S. district court, southern district of California. United States of America *vs.* —— ——. Complaint. Filed August 31st, 1893. E. H. Owen, clerk.

7 UNITED STATES OF AMERICA, }
Southern District of California, } *ss:*

The President of the United States of America to the marshal of the United States for the southern district of California and to his deputies or any or either of them, Greeting:

Whereas complaint on oath hath been made to me charging Fong Louie with a violation of the sixth section of the act of Congress entitled "An act to prevent the coming of Chinese persons into the United States," approved May 5, 1892:

Now, therefore, you are hereby commanded, in the name of the President of the United States of America, to apprehend the said Fong Louie and bring his body before the district court of the United States for the southern district of California on Monday, the 4th day of September. 1893, at 10.30 o'clock a. m., that he may then and there be dealt with according to law for the said offense.

Given under my hand this 31st day of August, in the year of our Lord one thousand eight hundred and ninety-three, and of our Independence the one hundred and eighteenth.

E. M. ROSS,
U. S. District Judge in and for the
Southern District of California.

Attest, etc.:
[SEAL.] E. H. OWEN, *Clerk.*

8 By virtué of the within warrant I have the body of Fong Louie before the Honorable E. M. Ross this 4th day of September, 1893.

GEO. E. GARD, *U. S. Marshal,*
By W. B. GARD, *Deputy.*

(Endorsed:) No. 470. U. S. district court, southern district of California. United States of America *vs.* Fong Louie. Warrant of arrest. Filed Sept. 4th, 1893. E. H. Owen, clerk.

9 At a stated term, to wit, the August term, A. D. 1893, of the district court of the United States of America in and for the southern district of California, held at the court-room, in the

city of Los Angeles, on Monday, the 4th day of September, in the year of our Lord one thousand eight hundred and ninety-three.

Present: The Honorable Erskine M. Ross, district judge.

UNITED STATES OF AMERICA
vs.
FONG LOUIE. } No. 470. Sec. 6, Geary Act.

George J. Denis, Esq., U. S. attorney, appearing for the Government; defendant present in custody of the marshal. The marshal having made return on the warrant hereinbefore issued, this case is called. Now comes the U. S. attorney and presents a telegram which he had received on September 2, 1893, from the U. S. Attorney General, which telegram is read by the court, ordered filed, and a copy substituted in lieu thereof. F. J. Thomas, Esq., appears and reads a telegram from A. B. Hotchkiss, Esq., attorney for defendant, and asks that this cause be continued at A. B. Hotchkiss' request until September 6th, 1893, at 3 p. m.

By consent of the U. S. attorney it is thereupon ordered that this cause be, and the same hereby is, continued until Wednesday, September 6th, 1893, at 2.30 p. m.

10 Form No. 2.

The Western Union Telegraph Company.

21,000 offices in America. Cable service to all the world.

Thos. T. Eckert, general manager. Norvin Green, president.

Receiver's No.: —. Time filed: —. Check: —.

Send the following message subject to the terms on back hereof, which are hereby agreed to.

SEPTEMBER 2ND, 189–.

Dated Washington, D. C., —— 2nd.

To U. S. Att'y Denis, Los Angeles, Calif.:

I am advised by the Secretary of the Treasury that there are no funds to execute the Geary law so far as same provides for deportation of Chinamen who have not procured certificates of residence. On that state of facts circuit court of United States for southern district of New York made following order: "Ordered that blank be, and he hereby is, discharged from the custody of the marshal, and ordered to be deported from the United States whenever provision for such deportation shall be made by the proper authorities." Ask court to make similar order in like cases.

OLNEY, *Att'y Gen'l.*

Read the notice and agreement on back.

All messages taken by this company are subject to the following terms:

To guard against mistakes or delays, the sender of a mes-
11 sage should order it repeated—that is, telegraphed back to the originating office for comparison. For this one-half the regular rate is charged in addition. It is agreed between the sender of the following message and this company that said company shall not be liable for mistakes or delays in the transmission or delivery or for non-delivery of any unrepeated message beyond the amount received for sending the same, nor for mistakes or delays in the transmission or delivery or for non-delivery of any repeated message beyond fifty times the sum received for sending the same, unless specially insured, nor in any case for delays arising from unavoidable interruption in the working of its lines, or for errors in cipher or obscure messages; and this company is hereby made the agent of the sender, without liability, to forward any message over the lines of any other company when necessary to reach its destination.

Correctness in the transmission of a message to any point on the lines of this company can be insured by contract in writing, stating agreed amount of risk and payment of premium thereon at the following rates, in addition to the usual charge for repeated messages, viz., one per cent. for any distance not exceeding 1,000 miles, and two per cent. for any greater distance. No employee of the company is authorised to vary the foregoing.

No responsibility regarding messages attaches to this company until the same are presented and accepted at one of its transmitting offices, and if a message is sent to such office by one of
12 the company's messengers he acts for that purpose as the agent of the sender.

Messages will be delivered free within the established free-delivery limits of the terminal office. For delivery at a greater distance a special charge will be made to cover the cost of such delivery.

The company will not be liable for damages or statutory penalties in any case where the claim is not presented in writing within sixty days after the message is filed with the company for transmission.

THOS. T. ECKERT,
General Manager.
NORVIN GREEN,
President.

(Endorsed:) Nos. 468, '69, '70, '71, '72, '73. U. S. district court, southern dist. of California. Substituted copy of telegram from Attorney General. Filed Sept. 4th, 1893. E. H. Owen, clerk.

13 At a stated term, to wit, the August term, A. D. 1893, of the district court of the United States of America in and for the southern district of California, held at the court-room, in the city

of Los Angeles, on Wednesday, the sixth day of September, in the year of our Lord one thousand eight hundred and ninety-three.

Present: The Honorable Erskine M. Ross, district judge.

THE UNITED STATES OF AMERICA *vs.* FONG LOUIE. } No. 470. Prosecution under Sec. 6 of the Geary Act.

U. S. attorney Denis appeared for the Government; defendant is present in court in custody of the U. S. marshal, with counsel, A. B. Hotchkiss, F. J. Thomas, and R. A. Ling. Thereupon Oscar Lawler is sworn as reporter, and plaintiffs, to sustain the issue, having called as witnesses W. A. Hammel, W. B. Gard, W. F. Lintner, and E. E. Maxwell, who are severally and respectively duly sworn and give their testimony, and the Government having thereupon rested, and defendant having moved to dismiss the proceedings, which motion is denied, to which defendant excepts, and thereupon Ah Fawn having been sworn as interpreter, and Fong Louie having been called as a witness and having been duly sworn, and, through interpreter (Ah Fawn), having given his testimony, and defendant, further to sustain the issue on his side, having called as a witness I. R. Dunkelberger and Mr. Hay, who are severally
14 and respectively duly sworn and give their testimony, and the matter being submitted, the court announces its decision as follows:

I find from the evidence and from the defendant's personal appearance and from his language, dress, and association that defendant is a Chinaman, and from his occupation that he is a laborer, and that he was such on the 5th day of May, 1892, and was then a resident of Los Angeles county, California, and has since remained such, and that he did not register in accordance with and in pursuance of the act of Congress of May 5th, 1892; that no excuse has been shown on his part for his failure to register, and upon those facts I order that he be deported to China. Findings, order, and judgment will be prepared accordingly.

15 In the District Court of the United States, Southern District of California.

UNITED STATES OF AMERICA, Plaintiff, *vs.* FONG LOUIE, Defendant. } No. 470.

Findings, Order, and Judgment.

A verified complaint having been filed in this court charging Fong Louie with a violation of the sixth section of a certain act of Congress approved May 5, 1892, entitled "An act to prohibit the coming of Chinese persons into the United States," and a warrant for the arrest of the said Fong Louie having been issued by me, Erskine

M. Ross, United States district judge in and for the southern district of California, made returnable before the district court for the southern district of California on the 4th day of September, 1893, and the said Fong Louie having been duly apprehended upon said warrant by the United States marshal in and for the southern district of California and brought before the said court upon the 4th day of September, 1893, and thereafter, upon the 6th day of September, 1893, a hearing was thereupon had of the matters charged in said complaint, the United States of America being represented by its attorney, George J. Denis, Esq., and the said Fong Louie
16 by A. B. Hotchkiss and F. J. Thomas, Esqs., and testimony having been adduced, I, Erskine M. Ross, judge as aforesaid, from such testimony do find that said Fong Louie is by race, color, dress, and appearance a Chinese person, and is and was at the times hereinafter stated a laborer by occupation; that he was a resident of the State of California, to wit, of the county of Los Angeles, at the time of the passage of the act of Congress of May 5, 1892, and has since continued such resident; that said Fong Louie was, after May 5, 1893, found to be a resident within the jurisdiction of the United States and of this district without the certificate of residence provided for in the act of Congress above referred to; that the said Fong Louie has neglected, failed, and refused to comply with the provisions of said act in this, to wit, that he, the said Fong Louie, a Chinese laborer, neglected, failed, and refused to apply for and obtain the certificate of residence required by said act; that Fong Louie has not established to my satisfaction that, by reason of accident, sickness, or other unavoidable cause, he was unable to procure such certificate; that said Fong Louie is unlawfully within the United States:

Now, therefore, I, Erskine M. Ross, judge as aforesaid, upon the foregoing facts do hereby order that said Fong Louie be removed from the United States to China; and it is further ordered that said deportation of the said Fong Louie be made from the port of San Francisco, within the limits of the northern district of California,
17 and that he be hereby committed to the custody of the United States marshal for the southern district of California to carry out this order.

Dated at Los Angeles, this 8th day of September, A. D. 1893.

E. M. ROSS,
District Judge of the United States for the Southern District of California.

(Endorsed:) No. 470. In the district court of the United States, southern district of California. The United States of America *vs.* Fong Louie. Findings, order, and judgment. Filed Sep. 8, 1893. E. H. Owen, clerk; Wm. M. Van Dyke, deputy.

18 At a stated term, to wit, the August term, A. D. 1893, of the district court of the United States of America in and for the southern district of California, held at the court-room, in the city of Los Angeles, on Friday, the eighth day of September, in the year of our Lord one thousand eight hundred and ninety-three.

Present: The Honorable Erskine M. Ross, district judge.

THE UNITED STATES OF AMERICA
vs.
FONG LOUIE.
} No. 470. Prosecution under Section 6 of the Geary Act.

Now comes F. J. Thomas, Esq., of counsel for defendant, and moves that proceedings be dismissed and defendant discharged; which motion the court declines to entertain; to which ruling defendant excepts; and thereupon defendant, by counsel, moves the court for a stay of proceedings in order that an appeal may be allowed; which motion is by the court denied; to which ruling defendant excepts.

19 In the District Court of the United States of America, Southern District of California.

UNITED STATES OF AMERICA, Plaintiff and Respondent,
vs.
FONG LOUIE, Defendant and Appellant.
} No. 470.

The above-named defendant and appellant, conceiving himself aggrieved by the final judgment duly made and entered in the above-entitled cause on the 6th day of September, 1893, and by the order duly made and entered on the 8th day of September, 1893, doth hereby appeal from said final judgment and said order to the Supreme Court of the United States, and he prays that his appeal may be allowed, and that a transcript of the record and proceedings and all papers on which said order was made in the said cause, duly authenticated, may be sent to the Supreme Court of the United States.

Dated this 8th day of September, 1893.

A. B. HOTCHKISS,
FRANCIS J. THOMAS,
Attorneys for said Defendant and Appellant.

Application being made to me for the allowance of the foregoing appeal, the same is refused, there being, in my opinion, no appeal from the order of deportation.

Los Angeles, September 8th, 1893.

ROSS,
District Judge.

20 Received copy of within this 8th day of September, 1893.

GEORGE J. DENIS,
United States Attorney.

(Endorsed:) 470. In the district court of the United States of America, southern district of California. United States of America, plaintiff and respondent, *vs.* Fong Louie, defendant and appellant. Filed Sep. 8, 1893. E. H. Owen, clerk; Wm. M. Van Dyke, deputy. Francis J. Thomas, 22 Temple block, Los Angeles, Cal., attorney-at-law.

21 In the District Court of the United States of America in and for the Southern District of California.

THE UNITED STATES OF AMERICA
vs.
FONG LOUIE. } No. 470.

I, E. H. Owen, clerk of the district court of the United States of America in and for the southern district of California, do hereby certify the foregoing 16 pages, numbered from 1 to 16, inclusive, to be a full, true, and correct copy of the record and of all proceedings in the above and therein entitled matter.

Attest my hand and the seal of said district court of the United States for the southern district of California this
[SEAL.] 9th day of September, in the year of our Lord one thousand eight hundred and ninety-three, and of the Independence of the United States the one hundred and eighteenth.

E. H. OWEN,
Clerk of the United States District Court for the Southern District of California,
By WM. M. VAN DYKE,
Deputy Clerk.

(Endorsed:) No. 470. U. S. district court, northern district of California. In the matter of the application of Fong Louie for a writ of *habeas corpus*. Petition for writ. Filed September 11th, 1893. Southard Hoffman, clerk. Harvey S. Brown and
22 Thomas D. Riordan, attorney- for petitioner, 6 Montgomery avenue, San Francisco.

23 At a stated term of the district court of the United States of America for the northern district of California, held at the court-room, in the city of San Francisco, on Monday, the 11th day of September, in the year of our Lord one thousand eight hundred and ninety-three.

Present: The Honorable William W. Morrow, judge.

In the Matter of the Application of FONG LOUIE for a Writ of *Habeas Corpus*. No. 10738.

In this matter the application for the issuance of a writ of *habeas corpus* this day came on for hearing before the court—Harvey S. Brown, Esq., and Thomas D. Riordan, Esq., appearing as attorneys for the petitioner, and Charles A. Garter, Esq., United States attorney for the northern district of California, appearing on behalf of the United States—and, after hearing Mr. Riordan and Mr. Garter, it is by the court now here ordered that the application for the issuance of a writ of *habeas corpus*, as prayed for in the petition herein, be, and the same is hereby, denied, and that said petition be, and the same is hereby, dismissed.

24 United States District Court, Northern District of California.

In the Matter of the Application of FONG LOUIE for a Writ of *Habeas Corpus.*

Notice of Appeal.

The petitioner in the above-entitled proceeding, feeling himself aggrieved by the order heretofore made and entered herein in the district court of the United States in and for the northern district of California on the 11th day of September, 1893, declining to grant a writ of *habeas corpus* as prayed for in the petition herein and dismissing the petition, doth hereby appeal from the said order of said district court to the Supreme Court of the United States, and he prays that a transcript of the record and proceedings and papers upon which said order was made, duly authenticated, may be sent to the Supreme Court of the United States.

San Francisco, September 11th, 1893.

HARVEY S. BROWN AND
THOS. D. RIORDAN,
Attorneys for the Petitioner and Appellant.

Due service of a copy of the within is hereby admitted this 11th day of Sept., 1893.

CHAS. A. GARTER,
U. S. Attorney, North. Dist. of Cal.

(Endorsed:) Filed Sept. 11th, 1893. Southard Hoffman, clerk.

25 In the Supreme Court of the United States.

In the Matter of the Application of FONG LOUIE for a Writ of *Habeas Corpus.*

FONG LOUIE, Appellant and Plaintiff in Error,
vs.
THE UNITED STATES OF AMERICA and GEORGE E. GARD, U. S. Marshal in and for the Southern District of California, Respondents and Defendants in Error.

Assignment of Errors.

Afterwards, to wit, on the 11th day of September, 1893, comes the said appellant and plaintiff in error, by Harvey S. Brown and Thos. D. Riordan, his attorneys, — says that in the record and proceedings in the above-entitled matter there is manifest error in this, to wit:

First. That the district court of the United States in and for the northern district of California erred in declining to grant the application for a writ of *habeas corpus* and dismissing the petition filed

herein, because the sixth section of the act of Congress ap-
26 proved on the 5th day of May, 1892, and entitled "An act to prohibit the coming of Chinese persons into the United States," etc., and each and every part thereof is unconstitutional and void and of no effect.

Second. That the said district court of the United States in and for the northern district of California erred in declining to grant the application for the writ of *habeas corpus* and dismissing the petition filed therein, because the presentation to and filing of a complaint with the Hon. E. M. Ross, United States district judge in and for the southern district of California, and the issuance of a warrant thereon was in excess of the jurisdiction of said judge, and therefore all proceedings had thereafter were illegal, void, and of no effect.

Third. That the district court of the United States in and for the northern district of California erred in declining to grant the application for the writ of *habeas corpus* and dismissing the petition filed therein, because the respondents in error had no warrant or authority of the law to confine or imprison the petitioner nor to detain him in custody.

Fourth. That the district court of the United States in and for the northern district of California erred in not issuing the writ of *habeas corpus* prayed for in the said petition and thereafter discharging said petitioner upon the facts set forth in the said petition.

Wherefore the said petitioner prays that the order of the district court in and for the northern district of California, entered on the 11th day of September, 1893, declining to grant the application for the writ of *habeas corpus* and dismissing the petition filed therein, be reversed, and that the district court of the United States be ordered
to enter an order granting a writ of *habeas corpus* as prayed
27 for in said petition.

HARVEY S. BROWN AND
THOS. D. RIORDAN,
Att'ys for Appellant and Plaintiff in Error.

Due service of a copy of the within is hereby admitted this 11th day of Sept., 1893.

CHAS. A. GARTER,
U. S. Attorney for North. Dist. of Cal.

(Endorsed:) Filed Sept. 11th, 1893. Southard Hoffman, clerk.

28 UNITED STATES OF AMERICA, }
Northern District of California, } ss:

I, Southard Hoffman, clerk of the district court of the United States in and for the northern district of California, in the ninth judicial circuit, do hereby certify that the foregoing pages, numbered from 1 to twenty-seven (27), inclusive, contain a true and complete transcript of the record and proceedings had in said court in the matter of the application of Fong Louie for a writ of *habeas corpus,* as the same remain of record on file in said office.

In testimony whereof I have caused the seal of the said court to be hereunto affixed, at the city of San Francisco, in the northern district of California, in the ninth circuit, this 13th day of September, in the year of our Lord one thousand eight hundred and ninety-three, and of the Independence of the United States the one hundred and eighteenth.

Seal of the U. S. District Court, Northern Dist. of California.

SOUTHARD HOFFMAN, *Clerk.*

Endorsed on cover: Case No. 15,400. N. California D. C. U. S. Term No., 1016. Fong Louie, appellant, *vs.* The United States and George E. Gard, United States marshal for the southern district of California. Filed September 22d, 1893.